20-498 Field

IN EQUITY.

Supreme Court of the United States.

No. ~~381.~~ 48

THE RUBBER TIP PENCIL COMPANY,

Appellants,

vs.

SAMUEL E. HOWARD,
HENRY SANGER,
MICHAEL SNOW, and
RICHARD BUTLER,

Respondents.

Appellants' Brief.

JOHN S. WASHBURN,

Counsel.

NEW YORK:
FRANK McELROY'S NEW STEAM PRINTING HOUSE,
99 AND 101 WILLIAM STREET.
1874.

Supreme Court of the United States. 1

THE RUBBER TIP PENCIL COMPANY,
Appellants,
vs.
SAMUEL E. HOWARD, HENRY SANGER, MICHAEL SNOW, and RICHARD BUTLER,
Respondents.
} *In Equity.* 2

STATEMENT.

This is a suit for infringement of the patent of J. B. Blair, dated July 23, 1867, for a "rubber head for lead pencils," (Exhibit, No. 1, fol. 555), which only of the several patents set forth in the Bill is in controversy in this suit.

Blair originally filed his application, January 6, 1859. 3
It was rejected and withdrawn, (Complainants' Exhibit X, fol. 558, 592).

November 3, 1865, he signed a new application, filed January 18, 1866, (Exhibit No. 10, fol. 573), and sold and conveyed (Exhibit No. 9, fol. 572), all his right, title and interest in said invention, to Levi L. Tower, who had previously, in ignorance of Blair's application of January 6, 1859, purchased, and invested a large sum of money in operating the patent of W. W. Shaw, dated April 5, 1859, which had been re-issued to him as assignee, June 4
24, 1862 (Defendants' Exhibit X, fol. 473).

Thus being the owner of the patent of Shaw, and of the rights of Blair, Tower petitioned the Commissioner

5 of Patents for a declaration of interference between said patent and applications, upon the grounds and for the reasons stated in his affidavit, (Exhibit D, fol. 440).

Such interference was declared (Exhibit E, fol. 443), and resulted in priority being awarded to Blair, May 15, 1867, (Exhibit F. fol. 448), and in granting to him said patent, July 23, 1867, which was also assigned by him to said Tower, August 3, 1867 (Exhibit No. 2, fol. 559), and by said Tower, to complainants, July 27, 1869 (Exhibit No. 3, fol. 560).

6 The defences set up in the answer are briefly, alleged prior invention, knowledge and use by Joshua Gray; also by Holman J. Hale; and also by said W. W. Shaw.

Also, that the invention in question was described in a specified prior printed publication.

Also, public use, and sale of the invention in this country, with the knowledge, acquiescence and consent of the inventor and patentee for more than two years before application for the patent, and abandonment to the public..

7 There were, as the record shows, pending at the same time, three suits, including this, by complainants against different defendants, all of whom are, however, united in interest, and of whom Samuel D. Hovey is the active defendant, from whom the others derive any rights they claim in opposition to said Blair patent and Complainants; in all which suits, so far as the Blair patent is concerned, the answers are substantially the same; and it was stipulated that the testimony taken in either should be considered taken in each, and read upon the hearing 8 accordingly, so far relevant. Fol. 51.

This cause was heard at the February Term of the United States Circuit Court for the Southern District of New York, by consent, before the Hon. CHARLES L. BENEDICT, in the Eastern District of New York. His opinion, reported in 9 Blatch., R. 490, is, by stipulation, referred to and treated as part of the record. He dismissed the

bill upon the sole ground, that the specification and 9
claim of the Blair patent show an article which cannot be the *subject of a patent.*

Like decrees in the other two suits were entered in accordance with said decision.

Defendants admit, upon the record, they have sold rubber-heads for lead pencils, identical with Exhibit No. 4, (fol. 55); which is shown to be the invention described by Blair, (fol. 281), thus admitting infringement.

The questions involved are, briefly, that of *patentable* 10
subject matter, the *only* question considered by the COURT below, and said questions raised by the Answer and proofs.

Of the latter, that of public use and sale for more than two years before application, relates only to Blair's *renewed* application; the questions of the *continuity* of that with his original, and of *abandonment*, are, therefore, raised.

As to the alleged priority of *Gray* and *Hale*, the questions are raised by the proofs, of *identity of invention, reduction to practice*, and of *forfeiture*—by *Gray*, by with- 11
drawing his application and delaying more than thirteen years—and by *Hale*, by not applying for a patent for more than four years, and after Blair's application and Shaw's patent, and being rejected, making no further effort for more than six years, and being then held to have abandoned it—in case of *both* Gray and Hale, the invention having, in the meantime, been patented and put into extensive use by others.

In case of *Shaw*, the question of identity does not arise, but that of *priority* both in point of *fact* and of *law* is 12
raised by the proofs, *Blair* having been the *first* to apply for a patent, and priority having been subsequently awarded to him.

The prior printed publication is only the *plate* of a "*nipple.*" Oue witness (*Oelzner*) testifies to some prior sale of such "nipples," *for nursing babes;* also, to his using them to rub out pencil marks but "*only for private*

13 *use*," and "*more for play them anything else*," but he cannot fix the time, nor is priority proved. The questions of *sufficiency*, *identity* and "*double use*," are, thereby, raised.

ASSIGNMENT OF ERRORS.

The COURT below erred in dismissing the bill.

The COURT held that the specification and claim show an article which cannot be the subject of a patent, and, therefore, "that the patent in question cannot be upheld for want of invention": and this, Judge BENEDICT says,
14 "renders it unnecessary for me to express any opinion upon the question of abandonment, so largely discussed at the hearing, nor to determine whether the patent in question is for the same invention described by Joshua Gray, in his application for a patent, and by others who have been relied on by the defence, as showing prior invention."

It is to be observed, that this question was not argued by either side, but was raised by the JUSTICE of his own motion, and as rendering unnecessary the consideration of any of the questions relied upon by the defence, and
15 argued upon the hearing.

The reasoning by which Judge BENEDICT reaches this conclusion is briefly this:

That the specification states the invention to be a rubber cap or head, to be applied to lead pencils &c., for the purpose of rubbing out pencil marks; and consists in making said head of any convenient external form, and forming a socket longitudinally in the same to receive one end of a lead pencil or a tenon extending from it.

16 That said head may be of any shape that may be desirable, and the socket may be of any proper shape, and extend partly or entirely through the head.

That this elastic erastive head is so made to fit upon the lead pencil, at or near its end, as to surround the part on which it is to be placed, and to be held thereon by the inherent elasticity of the material of which the head is composed.

He says: "It is to be noticed that the invention is not 17
stated to be a combination, but a single article of manufacture, namely: An elastic, erasing pencil head."

That is not stated to consist in its elasticity, or in its erasive capacity—both of which are qualities of the material used.

That, though an effort was made to show that the erasive capacity of the Blair head is increased by means of certain swells or projections on the sides of the head, which are portrayed in the drawings, and supposed to be 18
indicated in the specification as a feature of the invention claimed, he finds "no language which can fairly be said to convey the idea that such swells or projections form a part of the invention." On the contrary, that the description states that the head may be "of any convenient external form," and expressly declares that the invention "is not limited to the precise forms shown in the drawings, but may have any convenient form, so long as it is made so as to encompass the pencil and present an erasive surface about the sides of the same."

19

He, therefore, construes the invdntion claimed to be really "broadly any form which will enable the rubber to encompass a pencil, ink-eraser, or other articles of like character," and holds that the additional words, "and present an erasive surface about the sides of the same," add nothing to the description, because, he says, "it is impossible to have a piece of rubber encompass a pencil, ink-eraser, or other article of similar character, without presenting an erasive surface about the sides of the sam e.'

20

He says: "From this form which the inventor gives to a piece of rubber, otherwise to be of any convenient form, and from this form alone does his article derive its value as distinguished from rubber in any other form."

He continues: "By means of this form any person is enabled easily to attach the rubber to a pencil, ink-erase

21 or other article of similar character, and the only useful result obtained by the invention in question is that the head can be so easily attached to any pencil;" and this he holds to be accomplished by "simply the hole made in the rubber."

Therefore, he holds that there must be "a piece of rubber with a cavity in it" to constitute such a pencil head as Blair's specification describes, and that "there need be nothing more," which cavity may be of any shape, and and go through or partly through the piece of rubber,
22 and of all sizes.

And he concludes: "The article sought to be secured by this patent briefly and yet, as I think, fully described, consists, therefore, of a piece of india-rubber, with a hole in it. I am unable to fix any other limitation to the invention by any fair use of the language employed in this specification and claim."

And he holds that such an article cannot be the subject of a patent, because the elastic and erasive properties of india-rubber were known to all; and "no person
23 knowing the elastic quality of rubber could be wanting in the knowledge that a piece of rubber could be made to encompass and adhere to a pencil, ink-eraser or other article of similar character, by making a hole in it; nor could any one be deficient in the skill requisite to make such a hole."

Therefore, he decides that the Blair patent cannot be upheld for want of invention.

24

First:—The subject matter of the invention.

1. The construction by the Court below of the specification and claim is *illiberal*, and, it is claimed, *substantially erroneous* contrary to the just rule laid down in *Turrill* v. *Mich. S. & N. I. R. R. Co.*, 1 Wall., 491, and *Ames*

v. *Howard*, 1 Sum., 482, and again asserted and sustained by Justice CLIFFORD, in *Goodyear Dental Vulcanite Co., et al.* v. *Gardner*, that patents for invention are to receive a *liberal interpretation*, and are, if practicable, *to be so construed as to uphold and not destroy the right of the inventor.* 25

And there exists, in the present case, no necessity which *compels* such construction, which can be adopted only by rejecting the *substantial effect* of the language of the specification, as explained by the *drawings*, and disregarding the sufficiently manifest *intent* and *meaning* of the *inventor*.

26

2. To restrict the invention to the absurdity of only "*a piece of rubber with a hole in it*," shows a want of comprehension of its real scope and value, which for years have been fully appreciated by the public. The invention claimed and described, is something more than that.

The claim is for "an elastic, erasive pencil head, made substantially in manner described;" and in *Seymour* v. *Osborne*, 11 Wall., 516, 547, it was held by the SUPREME COURT, CLIFFORD, J., that "Where the claim immediately follows the description of the invention, it may be construed in connection with the explanations contained in the specifications, and where it contains words referring back to the specifications, it cannot properly be construed in any other way." Citing *Curtis on Patents*, 3d ed., secs. 225–227. 27

The same was held in the recent case of *Roberts* v. *Dickey*, STRONG, J., MCKENNAN, CIRCUIT J., 1 *Off. Gaz.*, 4, 6.

It is described in the specification as an "improved" rubber, or erasive head, for lead pencils, and shown in the specification and drawings to be a *solid, elastic, socketted, erasive head*, "so made as to fit upon a lead pencil at or near the end thereof, and to be so made as to surround the part on which it is to be placed, and to be held thereon by the inherent elasticity of the material, 28

29 of which the head may be composed," and having the *projecting, working erasive* surfaces shown in the drawings, which it is stated are "constructed in accordance with my invention," and by which drawings the invention is stated to be "represented."

It is true that the following language is contained in the specification (Complainant's Exhibit, No. 1, fol. 558): "The drawings exhibit the elastic head, so made as to *cover the end* as well as to extend around the cylindric sides of the pencil, but it is evident that the *contour* of said head may be varied to suit the fancy or the taste
30 of an artist or other person; and I do not limit my invention to the precise forms shown in the drawings, as it may have such, or any other *convenient for the purpose*, so long as it is made so as to encompass the pencil, and present an erasive surface about the sides of the same."

From this language Judge BENEDICT hastily assumes that the head may be of *any* external form whatever, so long as it encompasses the pencil, and that the words "and present an erasive surface about the sides of the
31 same" add nothing, "as it is impossible to have a piece of rubber encompass a pencil, ink-eraser or other article of similar character, without presenting an erasive surface about the sides of the same."

This is evidently a misconception.

The language quoted should be taken in connection with the language preceding (fol. 557), "The said head may have a flat *top* surface, or its *top* may be of a semi-circular or conical shape, or any other that may be desirable. Within one end of the said head I form
32 a cylindrical or other proper shaped cavity. This socket I usually make about two-thirds through the head, and axially thereof; but if desirable, the socket or bore may extend entirely through the said head."

It is evident that the statement that the *contour* may be varied, and that he does not limit himself to the "*precise*" forms shown in the drawings, is made with refer-

ence to the "end" of the pencil being *covered* or *uncovered*, and is subject to the express condition, that the forms shall be "*convenient for the purpose*," and the implied condition, to be fairly derived from the use of the word "*precise*," that they *must* correspond *substantially* with the *drawings*. There is certainly nothing from which it can be fairly derived that he intended to *disclaim* the features which are clearly portrayed in the drawings, upon which its practical value as an eraser depends; and the use of the words "to suit the fancy or the taste of an artist or other person," clearly confines the meaning of the inventor to a matter of *simple style*, and indicates that he does not limit himself to a *precise contour* as a matter of ornamental *configuration;* and this is further indicated by the fact that, in the drawings, while the *top* of the head is *varied*, and the *contour* of the projecting erasive working surfaces about the sides may be varied from hexagon to square or circular, the *projecting, working surfaces themselves* are always retained. 33 34

It is also evident from the whole context, that the words "and present an erasive surface about the sides "of the same" mean *such* erasive surface as is portrayed in the drawings, and as is "*convenient for the purpose.*" 35

Judge BENEDICT admits that these "swells or projections on the side of the head," by which the erasive capacity is increased, and which are claimed as a feature of the invention "*are portrayed in the drawings.*" But he says he "finds no *language* which can fairly be said to convey the idea that such swells or projections form a part of the *invention.*" But this is evidently founded upon the construction he puts upon the language already quoted. 36

Therefore, he virtually *ignores* and *disregards* the *drawings*. But the drawings must necessarily be correct delineations of the invention, while the language of the specification may be indefinite and open to misconstruction.

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37 And it is well settled by all the authorities, that the drawings constitute a part of the specification, and are to be resorted to to *aid* a specification, which would otherwise be *imperfect;* to *help out* the description; to furnish *clearer* information respecting the invention described in the specification; to show the *nature, character* and *extent* of the claim, as well as make a *part* of the description; and to *add* anything to the specification which is not *specifically* contained or mentioned therein.

Earl v. *Sawyer*, 4 Mass., 9
38 *Burrall* v. *Jewett*, 2 Paige, 143.
Washburn v. *Gould*, 3 Story, 133, 138, 139.
Emerson v. *Hogg*, 2 Blatch., 9.
Hogg v. *Emerson*, 6 How., 485; 11 How., 606.
Winans v. *Schen. & Troy R. R. Co.*, 2 Blatch, 284
Heinrich v. *Luther*, 6 McLean, 348.
And other cases.

And the fact that the construction placed upon the language in the present case is *inconsistent* with what the *drawings* establish, is enough to show it to be a *miscon-*
39 *struction.* Even were only a doubt raised of its correctness, that doubt should, by the authorities already cited, operate to sustain rather than to defeat the patent.

3. It is farther urged, that, in holding the invention claimed and described to be simply "a piece of india-rubber with a hole in it," the COURT has not only failed to perceive the meaning and application of the language used, but has also ignored all requirements of shape and size, which are clearly shown, and without restriction to which the Blair head would not possess the utility which
40 has rendered it an article of such extensive sale and use.

For "*piece*" of rubber includes every possible form; whereas the rubber head shown in the drawings and substantially described is indicated and limited in general form and size.

A "*piece*" of rubber need not possess the requisite

solidity which is shown and is essential, and, without 41
which, sufficient elasticity to secure it to the pencil and give it the rigidity and firm support necessary for its practical use as an eraser, could not be obtained.

There is nothing from which such restriction must of necessity be derived. There is everything to show that it could not have been intended.

According to the decision, *any* form would be within the description, whereas, it is only any form "*convenient for the purpose*," and having the *characteristics*, and *erasive surface* shown in the drawings, and, it is claimed, sufficiently described. 42

Judge BENEDICT farther holds, that "the cavity may be round, square or any other shape."

Evidently its shape and size are to be regulated by the shape and size of the *pencil*, as is sufficiently indicated.

He holds, that "it may go through or partly through the piece of rubber."

This is true, provided always, that the head be the *solid head* with the *projecting, working erasive surfaces* 43
shown. The cavity is simply the means by which *such* a head is to be attached to a pencil.

But it is *not* true as including the idea of a *mere tube*, for that would have neither the characteristics or advantages of the Blair head.

With similar misconception of the invention the defendants endeavor to defeat the Blair Patent by attempted proof of an alleged prior attachment by *Holman J. Hale*, of a simple *pipe or tubing of rubber* over a pencil, in which 44
a configuration of projecting erasive surface, similar to that of the Blair head, was sought to be gained by making the end of the wooden pencil stock egg-shaped, over which the rubber tubing was stretched, and thereby forced to swell out.

As a matter of *fact*, this device is not shown until *subsequent* to Blair's invention, and application for a patent,

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As a matter of *fact*, this device is not shown until *subsequent* to Blair's invention, and application for a patent,

45 and the prior attachment by Hale of *rubber pipe* already in extensive use for various purposes, as an article of merchandise, over an ordinary cylindical pencil, even if it were satisfactorily proved, and could be said to involve any invention at all, never proceeded beyond *experiment* as a mere matter of *curiosity*, and was *abandoned*.

But the Blair head has *resident in itself*, in a convenient, simple and attractive form, these peculiar and advantageous properties and capability of adaptation which in case of a *tube of rubber* could be only imperfectly imitated even by combination with another device,—and then
46 could present no inducements to the public to adopt it; while they have almost universally adopted the Blair head; it has become an article of sale in every market, and almost indispensable to every office and business man, and a patent has been granted for it, under and in reliance upon the validity of which an extensive business, involving large investments of capital, has been created, and continued for years, and which until now has never been questioned.

47 This is not a case of merely superior skill or workmanship, nor are the differences such merely as might be suggested by judgment or taste. There are clearly all the *criteria* of invention in the new and useful features described and shown.

The Testimony of Complainant's expert, the late *Francis C. Treadwell, Jr.* (Complainant's Proofs, fols. 897–938, 944–958), is referred to as a clear exposition of the features of the Blair head, and as establishing the misconception of the invention apparent in the opinion of Judge BENEDICT.

48

4. The *novelty* and *utility* of the Blair head must be considered as *admitted* in the decision. But, assuming the construction given to the specification and claim to be correct, JUDGE BENEDICT holds the device to be *too simple* and *obvious* to be the subject of a patent.

He says, "how to make a piece of rubber encompass and adhere to another article was known to every person who had ever seen a rubber shoe." 49

He continues, "no person knowing of the elastic quality of rubber could be wanting in the knowledge that a piece of rubber could be made to encompass and adhere to a pencil, ink-eraser, or other article of similar character by making a hole in it, nor could any one, be deficient in the skill requisite to make such a hole."

And again, "By means of this form any person is enabled easily to attach the rubber to a pencil, ink-eraser, or other article of similar character, and the only useful result obtained by the invention in question is that the head can be so easily attached to any pencil." 50

It is urged that this conclusion of consequent want of invention is not well founded: For as novelty and utility are all that the Patent law requires, it is well settled that it is not a good objection that the arrangement and application claimed are so *simple* and *obvious* as not to be the subject of a patent.

McCormick v. *Seymour*, 2 Blatch., 243, NELSON J. 51

And in the recent case of *Roberts* v. *Dickey*, U. S. Circuit Court, Western District of Pennsylvania, STRONG, J., and MCKENNAN, Circuit J., 1 Off. Gaz., 4, 5—6, it was held, that *utility*, as ascertained by the consequences of an invention, is the real practical test of its sufficiency, and that, when utility is proved to exist in any great degree, a sufficiency of invention to support the patent must be presumed.

Nor is the question of patentability to be decided by the amount of *ingenuity* shown, but by the character of the *result*. *Curtis on Patents*, § 41. 52

Moreover, JUDGE BENEDICT is in error in considering the invention claimed to be *only* of the device by which the rubber is *attached* to the pencil. It is, also, of the head itself, and its peculiar resident characteristics shown.

For the preceding reasons, it is respectfully submitted,

53 that, so far as the point, upon which the decision is exclusively based is concerned, the decree dismissing the bill should be reversed.

Second :—The defence of alleged prior invention, knowledge and use.

It is well settled that a duly issued patent, when introduced in evidence by the complainant in a suit for infringement is *prima facie* evidence that the patentee is the original and first inventor of what is therein described
54 as his invention; and in connection with his original application, is *prima facie* evidence of invention at the date the application was *filed*.

Wilder v. *McCormick*, 2 Blatch. R., 34.
Corning v. *Burden*, 15 How. R., 270, 271.
Jones et al. v. *Sewall Adm'r*, 3 Off. Gaz., 630.
Johnson v. *Root*, 2 Cliff. R., 116.
Agawam Woolen Co. v. *Jordan*, 7 Wall. R., 596.
Blanchard v. *Putnam*, 8 Id., 428.

55 And where, as in the case of said Blair, the patentee has made *two* applications before he obtained the patent, it is, for this purpose, connected with and relates back to his *first and original application*, and is *prima facie* evidence of invention at the date *that* was filed, provided he has not *abandoned* the invention.

In the *Dental Vulcanite Co.* v. *Wetherbee*, 3 Fish., 87. CLIFFORD, J., it was doubted whether any *new* application is *necessary;* but, if it is, held to be well settled that the *second* application must be regarded as having been
56 filed *in aid of the first* on which the rejection took place.

In *Blandy et al.* v. *Griffith et al.*, 3 Fish., 609, the first application was rejected; public use was set up; it was held, SWAYNE, J., that the *second* application, although too late in itself is in the nature of a *petition of review* of the previous rulings, and relates back to the *prior* application.

And in *Singer* v. *Braunsdorf*, 7 Blatch., 521, more than two years' public use was shown prior to the second application; it was held, BLATCHFORD, J., that so long as there was not a *voluntary abandonment*, the patent should be held to have issued on the *first* application. 57

The defence contained in the answer that the invention had been in public use and on sale in this country, with the knowledge, acquiescence and consent of the inventor and patentee, for more than two years before the application for the patent, and had been abandoned to the public, is made with reference to his *renewed* application and depends, therefore, upon sustaining the charge of *abandonment*, since, otherwise, Blair's Patent must be held to relate back to his *original* application, and to prove *prima facie* his said invention at *that* date, which can only be defeated by proof of the invention, knowledge or use *prior to that date*. 58

The question of abandonment ~~fully~~ is, therefore, to be considered first.

I. It is denied, that as matter of fact or law, Blair ever *intended* to abandon or *did* abandon his said invention, or in any way forfeited his right to a patent, and it is claimed that the contrary is fully proved under the authorities, and that his delay is fully explained and justified. 59

The burden of proof of abandonment is strictly upon defendants. The issue of the Letters Patent is *prima facie* evidence that there has been no voluntary abandonment by the inventor of his invention to the public, either *before* or *after* his application for Letters Patent. 60

Johnsen v. *Fassman et al.*, U. S. CIRCUIT COURT, District of Louisiana, April, 1872, WOODS, J., 2 Off. Gaz., 94.
Adams v. *Jones*, 1 Fisher R. 530.

It is urged, that in the face of a *patent* under which for

years a large manufacture and sale of the invention and patented article has continued involving the heavy and present investment of capital and business enterprise, by third parties, assignees, relying upon the validity of the patent and invention, the court should seriously hesitate to find an *abandonment* to have occurred, in fact, *years ago*, which until now, has never been alleged, and the knowledge of which was necessarily unattainable; and which, if found, would involve the *entire destruction* of such capital and *obliteration* of what is now a valuable right, of which the *public* have for years had, and still have the benefit contemplated by the law.

While it is not denied that a conflict has, to some extent, existed as to the question of *abandonment* in the reported cases, as well as in the opinions of patent lawyers, and that authority for application of rules of strict construction of *negative acts* or *omissions*, and perhaps, of conclusive inferences from them, can be found, yet, it is believed, that the weight and later current of the decisions establish a more liberal rule as the better, and inclines the court, at least after a patent has been *granted*, to require *affirmative evidence of an actual intent to abandon*, or of such *gross laches* as to unmistakably indicate such intent, before a patent will, on this ground, be declared void.

By § 35 of the *Act of* 1870, upon the hearing of renewed applications, where prior applications had been rejected or withdrawn, it is provided that "abandonment shall be a considered as a *question of fact*."

Although this provision has special reference to *renewed* applications, and their hearing *prior* to the granting of the patent, and as hereinafter shown, a decided distinction in construction exists in *such* case, from that which should be applied to a case like the *present*, when it is sought to defeat a *patent already granted*, yet it affords, to some extent, a guide to the reasonable interpretation applicable to the general question.

It seems evident that under the statute provision, *mere* 65
withdrawal of a prior application is not to be construed to, of itself, show abandonment, but that an *intent* to abandon must be found otherwise than from the mere fact of withdrawal, which has no other office than to render necessary the decision of the independent *question of fact* of abandonment; for it is provided that abandonment shall be considered as a *question of fact*, upon the hearing of a renewed application, *after the withdrawal of a prior application* and were *such withdrawal conclusive of itself* there could be no open question.

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It appears reasonable that, at most, the fact of withdrawal must be open to all and every proper *explanation* denying inference from it of *intent* to abandon And in this view, as abandonment must necessarily be the *voluntary* act of the party, it is a question of *intention*, and no *inference* of the existence of such intention, from the mere fact of *withdrawal*, should be drawn, unless it stands *alone*, and cannot *otherwise* be accounted for, or met.

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If *reasons* for the withdrawal or omission to prosecute an application are given, which, although they may be alleged to be insufficient to *justify* the delay under ordinary circumstances, are yet proved to have, *in fact, in good faith, actuated the applicant*, whether from ignorance or misunderstanding, without the necessity of inferring an *intent* to abandon in fact, this would seem to be enough.

In *Wilder v. McCormick*, 2 Blatch., 33, it was held that it is wholly immaterial to the validity of the patent 68
whether invention was *long antecedent* to the application for a patent, or *directly preceding* it.

Nor does *lapse of time* or any mere period of delay *per se* constitute abandonment or deprive an inventor of his patent.

69 *Russell & Erwin Manufacturing Co.* v. *Mallory et al.*, U. S. CIRCUIT COURT, District of Connecticut, September, 1872, WOODRUFF, J., 2 Off. Gaz., 495.

Within these limits it would seem that *intent to abandon* is substantially to be proved by *affirmative acts.*

In *Singer v. Braunsdorf*, 7 Blatch. 521, more than two years' public use, was shown prior to the second application. Judge BLATCHFORD said: "So long as Singer did
70 not abandon *voluntarily* his application of 1850, there is no reason on the facts of this case, why the patent of 1856 should not, in respect to the question under consideration, be held to have been issued on the application of 1850, even though as between himself and the government, what took place in March, 1853, should be regarded as constituting a *second* application. It did not *invalidate* or *destroy* the *first application, or work an abandonment* of it by Singer."

71 Judge BLATCHFORD further said: "*Forfeitures and abandonments are not favored in law; they must be clearly made out.*"

To the same effect, Judge NELSON said, in *Pitts* v. *Hall*, 2 Blatch. 237: "Abandonment or dedication is in the nature of a forfeiture of a right, which the law does not *favor*, and it should be made out *beyond all reasonable doubt.*"

And in that case it was held that a mere *expression* of
72 an *intention* not to take out a patent, or the mere *declaration* of an *intention* to dedicate an invention to the public cannot be regarded as *equivalent* to an *actual* dedication.

In the *Dental Vulcanite Co.* vs. *Wetherbee*, 2 Cliff. R. 555; S. C., 3 Fisher R. 87, the patentee filed an application in 1855, which was rejected: he did not appeal or make any new application until 1864. Judge CLIFFORD

said: "Strong doubts are entertained whether any *new* 73
application is *necessary;* but, if it was, it is believed to be well settled that the *second* application must be regarded as having been filed *in aid of the first* on which the rejection took place," citing *Godfrey* vs. *Eames*, 1 Wall., 317.

(In this case the UNITED STATES SUPREME COURT substantially decided that the *continuity* of the *second* application with the *withdrawal* of the *first* was a question of *intention* to be submitted to the *jury*.)

The COURT continued: "Actual abandonment is not 74
satisfactorily proved; and it is not possible to hold that any *use* of the invention *without the consent* of the inventor, while his application for patent was *pending* in the Patent Office, can defeat the issue of the Letters Patent *after they were duly granted.*

The decision in this case was approved in the subsequent case of the *Dental Vulcanite Co.* v. *Gardner.*

In *Blandy et al.* vs. *Griffith et al.*, 3 Fish, 609, the first application was rejected, public use was set up; Judge 75
SWAYNE said: "The application of May 26, 1858, was in itself too late, but we think it may be properly held to have been in the nature of a *petition of review of the previous rulings* and to have *related back* to the *prior* application."

In *McManus* vs. *Butler*, 51 Barb., 436, which was analogous as being a question of the dedication to the public of *vested rights*, it was held that proof of abandonment must be *clear* and *unequivocal;* that the evidence must consist of "*clear, unequivocal and decisive* 76
acts," . . . "*amounting to an explicit manifestation" of the will to make a "permanent abandonment and dedication.*"

So in *Dyer* v. *Sandford*, 9 Metc., 395, it was laid down thus:

"By the rules of law, when it is contended that an owner has *voluntarily abandoned* his right, the proof

must go to this extent: first, That the acts relied on were *voluntarily done;* second, That the party doing the acts had *authority* to do them; and third, That the acts are of so *decisive* and *conclusive* a character as to indicate and prove the *intent* to abandon."

In the Appeal of McClintock to the SUPREME COURT of the District of Columbia, from the decision of the PATENT OFFICE, rejecting his application for a patent for improved cotton-bale ties, heard and decided since the present law went into effect, it was said: "Abandonment will not be *presumed* in force of law. The question of abandonment is a *question of fact* to be ascertained through proof. . . . Abandonment is the *voluntary act* of the party. The proof of it should be distinguished by some act, fact, or declaration that the party *intends* it."

In that case there was not only no *affirmative* evidence of *intent* to abandon, but there was, as in the case of *Blair*, affirmative evidence that the applicant did *not* intend to abandon.

The principle is, however, laid down so clearly and unconditionally, that the fact, that in that particular case, such affirmative evidence of intent *not* to abandon existed, does not weaken the statement of the rule.

In Adams *et al. v.* Edwards *et al.*, 1 Fish., 1, Judge WOODBURY thus instructed the jury, in relation to the alleged abandonment by Fitzgerald: "I instruct you, in point of law, with reference to the rejection, that the proof of abandonment of his application would depend upon two circumstances: whether he *meant* to give it up—to give up all in regard to it—or whether, being needy, he gave up during a short time, for want of funds. You would not trip up a man of genius, who had made a discovery, in consequence of a want of means to prosecute his labors to their final consummation, if you thought he intended to persevere. And even if the application *was* withdrawn—if he kept it up *in his own mind*, and *meant* to keep it before the Patent Office, if you think he did not

mean to abandon it, and did not, but merely *suspended* 81
operations, till he could get *means*, then all the other inventions would apply only to two years before 1836," the date of Fitzgerald's first application. And again, . . . "a parent does not often abandon his own child, an inventor does not abandon the fruits of his genious, except from some great cause. Was there any great cause which induced Fitzgerald or Wilder to abandon this invention?"

In *Sayles* v. *The Chicago and N. W. R. R. Co.*, 2 Fish., 523, in equity, the COURT said, . . . "the patent 82
law looks with indulgence upon the delays which arise from the *circumstances* of parties who make an invention; and it is only when the invention is *intentionally* abandoned or rejected, or the parties show by their acts that they have not done all that they can do, that the law declares that they shall not be protected in their invention."

In *Pierson* v. *Eagle Screw Co.*, 3 Story, 407, it was held that the inventor, and he alone, is competent to abandon his invention to the public, and no use by the public, except *with his knowledge and consent*, can be deemed an abandonment of his invention. 83

In *McCormick* v. *Seymour*, 2 Blatch., 240, it was held "that there must be some acts of the inventor indicating an *intention* on his part to devote his improvement to the public in general, in order to authorize the jury to come to the conclusion that he so abandoned it."

In the *Appeal of John W. Cochran* for Letters Patent for improvement in breech-loading firearms, decided De- 84
cember 1, 1869, the SUPREME COURT of the District of Columbia held, that an inventor having presented to the world through the medium of the Patent Office, the nature and character of his invention, a *right* to Letters Patent has accrued to him upon payment of the stipulated price, *which right, when once accrued, is not barred by any act of limitation.*

85 And that he is not to be prejudiced by *subsequent patents* granted by the Patent Office *after having wrongly refused his own application*, nor can be held to have *abandoned* his said application, the rejection of which was the fault of the *Patent Office*, because he "*was not sufficiently pugnacious and persistent to fight the office through to the bitter end.*"

In this case Cochran made his original application in January, 1859; it was rejected in February of the same year, and in February, 1860, a year after his rejection, he withdrew his application, and had refunded to him by
86 the office the sum of $20. In May, 1868, he filed a new application for substantially the same invention, and it was held by the Appellate Court that he had *not abandoned his invention by such withdrawal, or forfeited his right to a patent for want of diligence.*

The similarity of this to the present case of *J. B. Blair* is to be observed.

In *Johnsen* v. *Fassman et al.*, 1872, 2 Off. Gaz., 94, the rule was thus laid down:

87 "The rule to be deduced from the authorities on the question of abandonment after application for letters patent, we think to be this: that *after the issue of letters patent* the abandonment must be shown to be *positive, actual*, and *intentional;* or by *such gross laches as indicate unmistakably an intention to abandon the invention to the public.*"

It is claimed on behalf of appellants, that the *testi-*
88 *mony* fairly *disproves* the charge made by defendants, that, by withdrawing his first application for the invention in question, and his omission to prosecute it further, until the time of his second application, said Blair must be held to have *abandoned his invention to the public*, and that, therefore, his patent is *void;* but that, on the contrary, it fairly establishes the *continuity* of his *second*, with his *first* application, within the authorities cited.

J. B. Blair is an artist, and, at the time of his said application of January 6, 1859, and ever since, has resided in Philadelphia, practising his profession, having little contact with *business men*. From the time of his application he has hardly left the City of Philadelphia, except for the purpose of making studies for painting. He is an elderly, unmarried man, whose class of acquaintance was, and is, very small, and mostly with people in the photographic business. (Fols. 342–343.) 89

He says (fols. 343–344), "I worked at my profession mainly as applied to painting life-size photographic oil portraits, and so-called ivory-types. My pastime was mostly in the Mercantile Library, and also in the pursuit or study of various objects of invention." and says he supposes most people would call his life *retired*. "*It was always solitary*, and (his pursuits) rather irregular as to time. . . . . My habit was to spend a great deal of time in walking, and studying while I walked; and also a great deal of time in playing chess. I was, therefore, not brought into connection with *business men to any extent*." 90

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He states that, at and from the time of his said application, January 6, 1859, until 1868, *his means of subsistence were all derived from his painting*. He says, "from 1859 until 1868 I worked at painting, and earned enough to keep me along *very economically*. It was not regular in the form of a salary;" and he states that, prior to the sale of the invention covered by the application of 1859, he received no *other* income from any *other* source, and was possessed of no *other* property whatever, and had no *other* money, means, or income whatever, except as stated *as earned by him for his own subsistence economically*. (Fol. 344.) 92

He himself drew his said application of January 6, 1859, and the specifications, drawings, and other papers, and made the model, and employed no patent solicitor or lawyer therefor, "partly because I thought I could

93 do it *myself*, and partly because of the *expense*." (Fols. 344–345.)

In relation to withdrawing his said application, after its rejection (fol. 348), "The reason of that was that seeing *I did not know* how to proceed for myself, and that therefore I should have to employ an *agent:* and not having the *means* to go to such an expense, and also *needing the money* I preferred to withdraw it, and to *await my ability to pursue the subject.*"

Being asked if he knew or were informed that such
94 withdrawal might be considered to show, or tend to show, that he *abandoned* said invention to the *public;* he answered, "*No; I do not suppose it vitiated my right to my invention, for I had seen many accounts of patents granted on a renewed application under like circumstances. I only supposed I should lose the portion that is forfeited to the office—portion of money I mean.*"

He says that he *never stated to any one, or knowingly did any act, or intended in any way, at any time to abandon his said application;* but, on the contrary, that he *did*
95 state and *claim* that he *considered himself entitled to a patent therefor, and intended to make further efforts for that purpose,* and particularly so stated to *David Shive* and *Otto Haggenmiller,* of Philadelphia, and also to *E. D. Williams,* who is now not living. (Fol. 349.)

He states that he applied to *Callendine to advance him money to prosecute his claims,* and being asked why he did not apply to others, says (fols. 349–350), "I applied
96 to Callendine, because he was an *intimate acquaintance,* and we had been *in business to some extent, together.* I refrained from making application to others, as such application is generally fruitless, and it rather incurs contempt than otherwise for an inventor;" and he adds, "*I had no acquaintance of such a character as I would be willing to make a proposition of that kind to.*"

He states that it was *from six months to a year,* according to the impression upon his mind, *prior* to his assign-

ment of his said invention to Levi L. Tower, that he *first saw* rubber tips *on sale*, and that he was very much *surprised* at seeing them, and *apparently patented* (fol. 350); and (fol. 362) that though he cannot associate the time as six months to a year with any other events, "*the evidence itself is very distinct.*" 97

Being asked if he had any knowledge or information of any such patent *prior* to that time, he says:

"I feel almost certain that I did not, because of my surprise at seeing this apparent reproduction of my own invention in the windows." (Fol. 351.) 98

He states that he first saw rubber-tips similar to his own "in a window on the south side of Chesnut Street, or some other street, I think it was Chestnut Street, between Fourth and Third Streets." (Fol. 358.)

David Shive testifies that he has known Blair since 1857 or 1858 (fol. 229); that he was with said Blair at or about the date of his said application, "Perhaps three evenings out of every week. Was perfectly familiar and acquainted with what he was doing in this relation. I saw the models of different forms and shapes that he made, and the one that he *describes* here, but did not make, is the one *he set most store by—the one made purely of India-rubber—the cap.* We frequently consulted together as to *where* and *how* to have it made, and concluded that *to mould it* would be best." (Fol. 230.) 99

He states, (fols. 231–232,) he had *frequent conversations* with Blair between January 24, 1859 and 1866 inclusive, in relation to his *said application of January* 6, 1859, and his *invention*, and says: "*He always set a great deal of store by the invention, thinking it would yield him something nice ultimately. He considered that he was wrongfully rejected, and that at a proper time he would renew the application,*" and stated "*want of funds*" *as the reason for delay.*" 100

101 He says he "was painting photographs for a living, which was but a *scanty one.*" "He frequently said to me that he expected a *change* in his *circumstances*, and always seemed *very hopeful. . . . I heard him mention this invention in connection with his hopes and prospects for the better.*" Being asked how he mentioned it, he answers "That, of course, rested upon the matter of his *taking it up at the proper time.*" (Fol. 232.)

He states that these conversations and Blair's said statements to him occurred "during and between the
102 time of his *making the invention* and *parting with it*, and *frequently*, and extending over the *larger portion, if not the whole of the period.*" He further says that during such period said Blair's habits "were *very retired and secluded, having but very few associates or friends.*" . . . "They were persons somewhat of *his* stamp of character, mostly *inventors* or *artists.*" (Fol. 233.)

Otto Haggenmiller testifies that he has known said Blair since the fall of 1861 (fol. 239); that either in fall of 1861,
103 or very early probably in January, 1862, Blair told him "that *he was the first inventor of the hard rubber-headed pencils*, but that he didn't get a patent granted, and *he would follow the case up as soon as he had some means to do it.* We had several consultations—it might be during three, four or five months."

He states that Blair had this and other inventions, and offered if he would take hold of any of them, and *especially this rubber-head invention*, and would supply him with *money*, he would *give him a half interest in it.* He says,
104 "I asked him first, Why don't you push it?" and he told me, 'Well, you are green yet. You don't know what a patent law-suit costs in this country;' *and that scared me just off of this special patent.*"

In this connection witness states (fol. 244), "I remember distinctly that he was the first American gentleman that I had to do with."

He adds; "He told me right at the beginning of our acquaintance that some rubber-head pencils were in the market, and that he found out that several different patents were granted to *other* parties *after* his claim was refused, covering exactly the same thing that he claimed, *and to follow up those claims he wanted to get hold of me as partner.*" (Fol. 241.) 105

He farther says, (fol. 241), "I took interest in another of his patents, and so we kept acquaintance for about *four years*, and *during the whole time he was very anxious to raise money to push this claim.* He many times told me some one of his inventions would turn into some money and *enable him to push that very case.* He told me once it wanted very little genius to invent such a thing, but that the pencil *would command a large sale.* 106

And he states, (fol. 242), "His *pecuniary circumstances* were in a *very bad condition during the whole period.* He was all the time experimenting in a small way. *I don't believe he ever had twenty-five dollars in his pocket at a time.*" 107

Being asked as to his habits of life, he says, (fol. 243), "*He was always an industrious, sober man. He had very few acquaintances; he spent all his spare time in playing chess.*"

On cross-examination, he states (fol. 244), that Blair told him he considered it a "*big thing.*" "The talk was all the time on his side *to get hold of some one to push it* (this invention). We talked together a *hundred times about it probably*, and (fol. 245) *he claimed priority, and wished to push it as soon as possible.*" 108

He further states (fol. 246) that he remembers some particulars of another conversation about *a year later* than the first. That Blair *again* offered him to take hold of the claim for his pencil-head. That they had about the same talk; "but I wouldn't take hold of a pencil

109 with a *large lawsuit on the head of it.* He told me that time that it was probable that the other claims were in the hands of *some rich corporation.* He wasn't sure. *He didn't know the parties at that time*—and so much more I got frightened at it."

And (fol. 247) " He offered me any of his patents on half interest in case I would supply him with *money.* He never said any strict amount. He never wanted any money for *himself* on account of the patent. *He just offered me a half interest and wanted me to push it. I was*
110 *to manufacture, advertise, furnish all the money, do everything; he only wantea half of the profitt; that was exactly the conditions.*"

The decision in *Russell & Erwin Manufacturing Company* v. *Mallory et al.*, 2 Off. Gaz., 495, *supra*, upon the question of abandonment, although in that case prior to application, applies *a fortiori* to the case of *Blair.* It was held, WOODRUFF. J., that where, during a period of
111 delay in applying for a patent, the first inventor *had continued to assert his claim as such, and a purpose to secure a patent*, and had shown some, though inadequate, *appreciation of its value*, although *another* meanwhile made the same invention and put it *on sale*, there was *no abandonment*, either as a *useless experiment* or *to the public.*

And Judge WOODRUFF said (p. 490) " Webb's *continuous* or *repeated declarations*, testified to by himself and by the solicitor of patents to whom he applied for advice; his *claim to priority of invention* when he *heard* that *Mallory* was manufacturing a similar lock and latch; his
112 *offers to sell his invention to others, indicate* that in his mind there was *no purpose* to *forego* the right which belonged to him as *inventor*, nor any conclusion that the invention should be *abandoned.*"

And further said—while admitting that Webb could have easily procured means to pay the expense of taking out a patent, and that the sale of the patent for his second invention would have enabled him to do this—

"but it is plain what his purpose was in delaying his application. He did not propose to *himself* engage in business as a manufacturer. He had not *means* for such an undertaking. The profit of his ingenuity he expected to realize by *negotiation* with *others who* were or should become manufacturers." 113

Levi L. Tower testifies (fol. 91) that Blair said to him, that "in the fall of 1865 that he invented a moulded rubber head, and that a short time prior to this he had seen some of the said heads in a shop-window on Chestnut Street, Philadelphia; and that as soon as he had means he should take up his rejected application which was wrongfully rejected, as he believed, by the Patent Office, and prosecute it for a patent." And "That for want of funds within his reach and control he had not been able to prosecute his said claim for rubber head pencils." And again (fol. 160) "I had one of these rubber-head pencils in my hands; and asked him if he had ever seen one of these rubber head pencils; he said he had, for the first time, but a short time before, on Chestnut Street, in said city, and that it was his invention. . . . He said that he made application to the Patent Office in January, 1859. . . . He said it wus rejected by the office, and wrongfully, and as soon as he had means, or was able, he should take it up and prosecute it; that he attached a good deal of importance to it." And (fol. 161) "He said he thought he was the first and original inventor, and if I did not purchase it, as soon as he had means, he should take it up, and try to secure his rights from the Patent Office." 114 115

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It is claimed, therefore, that the defence of alleged prior invention, knowledge and use, is to be *confined* to a period *anterior to January* 6, 1859, the date of filing, of Blair's *original application.*

117 It appears to be now settled, that in order to thus defeat a patent, the *burden* rests upon *defendants* to establish this defence *beyond any reasonable doubt*, as to the *date* and *indentity* of the alleged prior invention, knowledge and use, and all the *elements* from which they are to be found, or upon which they depend; and that *nothing less* than such proof, *beyond any reasonable doubt*, can avail to defeat the Patent of said Blair.

The rule in this respect, is thus stated in the recent decision of the SUPREME COURT, in *Coffin* v. *Ogden et al.*,
118 October Term, 1873; Mr. Justice SWAYNE delivering the opinion of the COURT:—

"The invention or discovery relied upon as a defence must have been complete and capable of producing the result sought to be accomplished; and this must be shown by the defendant. The burden of proof rests upon him, and every reasonable doubt should be resolved against him. If the thing were embryotic or inchoate; if it rested in speculation or experiment; if the process prusued for its development had failed to reach the point of
119 consummation; it cannot avail to defeat a patent founded upon a discovery or invention which was completed, while in the other case, there was only progress, however near that progress may have approximated to the end in view. The law requires not conjecture, but certainty. If the question relate to a machine, the conception must have been clothed in substantial forms which demonstrate at once its practical efficacy and utility;" citing *Reid* v. *Cutter*, 1 Story's R. 590.

120 These, then, are the *tests* to be applied to the present case, and, it is claimed by appellants, that defendants have entirely failed to show any anticipation of Blair, sufficient to invalidate his said Patent.

II. The alleged prior invention, knowledge and use of said *Joshua Gray*.

Said Joshua Gray filed an *application* for a patent *September* 18, 1856, for an "improvement in pencils, pencil cases or holders," (Defendant's Exhibit A. fol. 425); which was rejected, (Id. fol. 429), and subsequently *withdrawn by him and the patent fee returned.* (Id. fols. 429–430). 121

It is in evidence, that, *after* the present litigation was commenced, said *Samuel D. Hovey*, being informed by his Patent Solicitor, Mr. Dodge of the *existence* of said Joshua Gray's said application, *ante-dating* that of *Blair*, at once hunted Gray up, and proposed to purchase it, and did purchase it for $500 down, and the agreement to pay $500 more when the patent should be granted; which bargain was made the first time Gray ever saw him, when Hovey came to him for that special purpose, and, at once, without the least hesitation or inquiry on Gray's part. 122

Fols. 301–302, 382–383.

Hovey then procured a *new* application to be filed in the name of Gray, December 31, 1869, after a lapse of *more than thirteen years*, (Defendants' exhibit, A. A. fol. 463), containing *new claims*, and very much *broader* claim than that of his *original* application, and so drawn as to *include* what was patented to said *Blair*, as well as *all other intermediate patents.* 123

But this *new* application was *rejected* on the ground, that Gray had withdrawn his original application, and suffered it to remain then over twelve years, without farther action; the subject of the application, in the meantime, having gone into *general and notorious use*; the rejection being, therefore, based on the ground of *abandonment.* (Id. fol. 472.)

Hovey then procured an *interference* to be declared between *Gray's application* and said *Blair's and other intermediate patents and applications.* 124

After long litigation, and persistent efforts on the part of Hovey and his associates, the defendants in these suits, the application was *denied* by the *Examiner in charge of Interferences*, by the *Board of Appeal*, and finally

125 by the *Commissioner of Patents*, who expressly, and in a very long and elaborate opinion, reported in *Commissioner's Decisions*, 1871, p. 129, held,

1. That said Gray *never perfected or reduced to practice* the invention claimed by him.

2. That he was *not the first inventor* of what he claimed.

3. That aside from the questions of *priority* and *completed invention*, he *forfeited* his invention.

126 4. That there was *want of identity* between his *original* and *renewed* application.

Said decisions of the several tribunals of the Patent Office, are in evidence.

(COMPLAINANT'S EXHIBITS, X. Y. AND Z).

And it is claimed by appellants, that, if these decisions do not techinally amount to *res adjudicata*, they are at least worthy of weight, as the conclusions to which independent tribunals experienced and skilled in the premises
127 have arrived upon the very questions and facts involved in the present suits so far as *Joshua Gray* is concerned; and especially as those questions arose and were discussed in that proceeding, as the *direct issues*, which are here set up in support of a defence.

It appears, therefore, that said renewed application in the name of said Joshua Gray, was prepared in the interests of said Hovey and his associates, including these defendants, with especial reference to the patent of said Blair, and *to appropriate to themselves* the invention of said
128 Blair, which had become of great value; although it was not described or even referred to in said Gray's *original* application.

This defence, therefore, is *disingenuous* and evidently made, not merely to defeat the Patent of Blair, but to secure the *defendants* the monopoly of his invention.

It is claimed by appellants that the testimony in the present suit, fully *sustains* the decision of the Patent Office in regard to Joshua Gray's alleged invention, and that this defence is in no respect sustained. 129

1. The alleged prior invention, use, and knowledge of said *Joshua Gray* were not such *perfected invention, public use*, or *knowledge* as can avail to defeat the patent of said J. B. Blair.

This is evident from the testimony of Joshua Gray himself. No such "*reduction to practice*," no such "*use*" of the alleged invention are shown as could render or was calculated to render it *accessible to the public* in the sense and to the extent required. 130

Besides filing his application of September 18, 1856, it does not appear that he did *anything whatever* to acquaint the public with it *prior* to said Blair's invention and application, with *one* exception; he testifies that he did make a *model* of the form of rubber-tip pencil described in the said *application*—(which, however, was entirely *different* from that of *Blair*)—and put it into the Mechanic's Fair in Boston, in, he thinks, September, 1856. (Fols. 298, 310.) 131

But he also states, that he does not know what has become of that model, and that he *last* saw it in September, 1856, at the time the fair was going on. (Fol. 308.)

It also appears that the model he made to be deposited in the *Patent Office* with his said application, (*also* entirely different from that of *Blair*,) and which, he says, he has never seen *since*, has long since *disappeared*. (Fol. 308.) 132

Being asked if he made any *other* models, or any *other* rubber-head pencils, or rubber heads for pencils whatever, except *these two models*, he first answers, "I made some; I do not know how many; *may be one, or two or three, or four, about the time—about* 1856; *and one*, I *think, in* 1861; I might have made more, but don't seem to recollect par-

133 ticularly." . . . "I do not recollect any more particularly." Being pressed, he says, "I might have made some more, but *I could not say positively that I did.*" Being asked what has become of these *other* "*one, or two, or three, or four*," he answers, "*one* was sent to Washington in 1861, as a *model*; I do not know what became of the *other*." (Fol. 309.)

And he states that the one he specifies as being made in 1861, was this one he sent to Washington as a model in 1861, and (fol. 312) that this was *simply a piece of rub-*
134 *ber tubing over the end of a pencil.*

Being asked when he *last saw* these different ones he *thinks* he made, he answers, "*I have not seen them for a long time; I could not say how long it has been, ... I think I have not seen them since about that time.*"

And being asked if he had since seen *any* which he made, or caused to be made at *any* time, as embodying his said invention, he answers, "I do not think that I have seen those models *since about the time that I made them.*" (Id.)

135

In addition to the testimony of Joshua Gray himself is that of but *two* witnesses, neither of which is more definite:

John Ray, who paid the expenses of Gray's 1856 application, and to whom Gray assigned a one-third interest in it, which Hovey *also* bought, says: (Fols. 323–324).

"I know that he invented a Rubber Tip Pencil in 1856; it was a piece of rubber cut out—or a hole cut in it—so
136 as to fit on to the end of a pencil, and into a *metallic cap, or cup;* I saw him at the same time, or about that time have a piece of rubber *with a hole cut entirely through it,* and also a piece of *rubber-tubing on a pencil.*"

He says, (fol. 824), Defendant's "Exhibit N" is "*a most perfect representation*" of that first described; but on cross-examination, (fol. 326) he says, "I could not say it

was *exactly* like it," and he specifies important differences; 137
then adds, "I should say it was a *fair representation*;"
and being asked if the metallic cap of "Exhibit N"
being removed, leaving the rubber head, it could be used
as an eraser, or if the head would come off, he answers,
"*You could not; it would come off.*" He also states, (fol.
325), that he saw the said rubber head attached to a
railroad switch model that was in the Mechanics' Fair,
and that it was similar to "*Exhibit N.*"

The other witness, *Edgar M. Stevens*, says, (fol. 327),
"I know that he (Gray) brought me a piece of rubber in 138
that style of a head, which he said was for pencils, lead
pencils; it was at my shop in Haverhill Street, Boston,
I think in the early part of '57." And Defendant's "Ex-
hibit O" being shown him, says, "It resembles it very
much, only in little better shape; 'Exhibit O' is."

Gray also applied to him, he say, for money "to get
the patents, and make some moulds, and *get the thing
perfected*," thus showing that it was not *then* perfected.

All, therefore, that Joshua Gray appears to have *actu-* 139
ally done to reduce his invention to actual practice, as
appears by his own testimony, prior to said Blair's appli-
cation, was to make *two models*, the one he gave to his
solicitor to send to the Patent Office, and the other he
put into the Fair, *both* of which were made as described
in his *said application* and *neither* of which he has *since
seen*. And these models, roughly cut out by hand, as
they are stated to have been, were hardly calculated to
attract the attention of, or present any inducements to
the public, and evidently failed to do so, but at once *dis-* 140
appeared, and were only revived in the interests of the
defendants in this litigation, after *patents* had been granted
to *independent* inventors, and the invention had gone into
extensive use.

His indefinite statement as to having made "one, or
two, or three, or four" others, cannot be regarded.

After said *Blair's application* he appears to have made

141 in 1861 *another model* for his *application of* 1861, for simply a *rubber tube.*

2. It is evident that Joshua Gray's alleged invention, merely experimental and imperfect as it was, was *not identical* with, or *substantially the same* as that of said *Blair.*

(*a*) It is true, Gray indefinitely testifies to have made two *other* forms of rubber tips, besides that described in his said *application of* 1856.

142 He says (fol. 296) "I took a piece of square rubber, perhaps half an inch or five-eighths square, and made a hole in of about three-eighths of an inch or more, and cut off the corners at the top, and whittled the bottom down so as to make it round, leaving the big part perhaps eight square; I also took a piece of rubber tube and cut it off and slipped it on, and I made one or more round, with the head larger at the top.

He states (id.) that he "*thinks*" these two forms did *not have* "*any metal ferrule or sleeve surrounding them,*" and
143 also (fol. 297), that he "*thinks*" he made these forms *before* his application. And, being cross-examined, he says, (fol. 307), "*I cannot swear whether they were all positively before*—I should *think* they were; I am very positive they were."

But it is evident, if he ever did devise any *other* form than that described in his *application of* 1856, save the simple *rubber tubing,* for which he applied for a patent in 1861, it was *subsequent* to said *Blair's application,* if
144 not entirely an *after-thought* in the interest of the defendants in this litigation, for

No *other* form than *that described is alluded to in his application of* 1856, and his present attempt to cast upon his Solicitor the responsibility for this, although the only alternative left, is to be distrusted, and at any rate cannot be urged to the prejudice of a *subsequent independent inventor who has obtained a patent.*

And the disclaimer contained in the specification of his application of 1861 (Complainant's Exhibit, No.——, fols. 584–585) is inconsistent with any such pretence. 145

He states, "I am aware that rubber heads have been applied to lead pencils, but not in so cheap and convenient a form as I apply them; nor were they so easily applied and removed as by the means which I have invented, nor so firmly held to the pencil."

But it does not appear that, in fact, he ever did actually make any model whatever of *any* form of rubber tip pencil, *except* those described in his said *application of* 1856 *and* 1861—of the *former but two*, the one given to his solicitor to be sent to the patent office, and the other put into the Mechanic's Fair,—and of the *latter but one*, a simple tubing, which he testifies he made in 1861 for a model for his said application of 1861. 146

Moreover, *George B. Sargent*, a witness previously called and examined by *defendants* themselves, who however studiously avoided all reference to *this* point, testifies (fol. 258) that Gray showed him his alleged invention in 1857 or 1858. He states, "*He had a silver pencil with the stone knocked out, and a piece of sheet rubber, I should judge it was, drawn over on to the pencil, so that it made the shape, on the outside, of a button.*" 147

He states (fol. 259), "Every day I used to see him, I lived in the same town with him. We rode out in the cars morning and night, and I would see him in the shop during the day," and that Gray showed him a silver pencil, the same as above described, and said it was a rubber head pencil, and (fol. 260) *was his invention;* and he states that he claimed *no other invention* than that embodied in the pencil he so *showed* him, and did not show him or inform him of any *other* model than *that one*. 148

As to the rubber, this witness testified (fols. 260–261),

149 "*It was sheet rubber—it was not solid;*" and he states he is *positive* as to that. "*It was drawn over the top and screwed on by the head*" from which the stone had been taken; and that defendant's "Exhibit N" differs from that model which Gray showed him, as "instead of being a piece of *solid rubber*, it was a piece of *sheet rubber drawn over on the pencil, and the head put on*, so as to form the shape of a button on the outside;" and "the one he showed me was a *silver* pencil,—this ("Exhibit N") is *wood*," and that in other respects "Exhibit N" is substantially similar to the model he showed him; and he identifies complain-
150 ant's "Exhibit Sargent No. 1" (Fol. 267) as resembling the *one* Gray showed him, except that the latter was a little neater job."

He states (fol. 261), that Gray never showed him any models similar to defendant's "*Exhibits O and P*," or stated that he had *invented* or *claimed* any *such* rubber pencil, as in said exhibits shown; and (fols. 264–265) that between the time Gray showed his model in 1857 or 1858, and the time witness went to Cutter, Tower & Co., to sell them
151 the invention, (1860) he was accustomed to see and converse with Gray *every day;* and being asked how often Gray showed his said rubber pencil, he says, "Perhaps every day or two he would show it to me or some one else in the shop," and that he was familiar with its appearance and construction to such extent that his memory is clear as to its being made as he states.

And it appears that this intimacy, and Gray's conversations with him about his said rubber pencil, continued until, certainly, 1860, when he states (fol. 265) he went,
152 at Gray's request to see Cutter, Tower & Co., about the rubber heads *they* were making, and to try to get them to *buy this one of Gray.*

[It is to be noticed that *Gray himself* testifies (fol. 298), that he got Sargent to see Mr. Tower, of Cutter, Tower &

Co., in 1862, "it might have been 1863—perhaps within a year or two after I found out that he was making them," and also, that Mr. Tower testifies positively (fol. 149) that he, or his firm, never manufactured or sold rubber tip pencils till about April, 1861; and (fol. 150) that he never knew or heard of any one else who made or sold rubber tip pencils prior to that, with the exception of a sample of heads made for a man by the name of Hale, the very last of 1860, or early part of 1861, and the rubber tips made or described by John B. Blair in his specifications and drawings (fol. 151.)] 153

154

John H. Brown, defendants' own witness, testifies on his direct examination, that *as late as* 1864 *and* 1865 Gray explained to *him* his invention "*as being a gold-headed pencil with the stone taken out, and a piece of rubber inserted in place of the stone, and also a piece of rubber tubing cut off and slipped on to the pencil*," (fols. 337–338.)

And defendant's witness, *John Ray*, mentions *no other forms*, except those described in said *applications* of 1856 and 1861.

155

There is, in fact, no evidence whatever that Joshua Gray ever really had the idea of any form of a rubber head pencil, *save that* applied for in 1856, and *that* applied for in 1861, and it is clear that he did not make the *latter* until 1861, *two years after the application of said Blair.*

(*b.*) It can require little save a comparison of *Gray's application of* 1856 with *Blair's Patent* to show the entire *want of identity* between the rubber head pencil described in the former, and the rubber head patented by the latter 156

Gray himself thus described his alleged invention. He states (fol. 306), that the inside of the metallic holder where the rubber fitted was *concave*, and that *without* the insertion of the pencil through the metallic holder and

157 into the head, *it would not hold the rubber firm*, but that by inserting the pencil through the holder and into the rubber, *the rubber would be forced into the cavity of the metallic holder, and thereby be firmly held* and he states *this* was the method by which he intended to *hold* the rubber and for an *ornament* to the pencil. He admits that but for the *metallic concave holder* the rubber "*would be liable to slip off;* it was made short in order to fit the metallic holder."

And defendants' witness, John Ray, states (fol. 326)
158 that the object of the metallic head on the pencil was "To give it *style* and *finish*." He afterwards says, "It was put on for style and finish, and also to support the rubber," but adds, that its *main* purpose was "*style* and *finish*," and admits (fol. 327) that if the metallic cup were *removed* leaving the rubber head, "You could not" (use it as an eraser), "it would come off."

Gray admits that the metallic head he used was simply the head of one of the old-fashioned silver pencils made with a stone inserted in it, which he removed, and in-
159 serted in its place a piece of rubber after he had made the metallic head concave, deeper and he thinks a little larger. (Fol. 310.)

He also admits (fol. 312), that he never made a moulded rubber head.

An attempt is made, it is true, to claim that the piece of rubber inserted was *solid* and that, *without* the metallic holder, it would be, *to some extent*, held on the pencil by its own elasticity.
160

An inspection of "Exhibit N," the language of Gray's application, and the testimony of Gray himself and Ray above quoted, are sufficient to show the *impracticability* of this, even if a solid piece of rubber as claimed, and to show that it never was intended to be fastened to the pencil otherwise than by the metallic holder.

But it is evident from the testimony of *George B. Sargent* already quoted, and from the drawing annexed, that it was *not* a piece of solid rubber, but was simply a piece of *sheet* rubber *bent over the end of the pencil, and secured by the metallic holder.* 161

In addition, the testimony of Complainant's expert, *Francis C. Treadwell, Jr.*, removes all possible question which might be raised as to the point of want of identity. (Fols. 274–281).

And defendant's own expert, *W. C. Dodge, admits* (fols. 391–392), that, "assuming that the Gray head consisted of a sheet of rubber folded or doubled over the end of the pencil, and held in place by the metal socket or ferrule, which I understand to be your assumption, then I should say that the Blair Patent does contain an independent invention, and that that consists in its method or means of attachment to the pencil;" and he states that by 'folded' or 'doubled' he means "a head composed of a *thin sheet* or *disc of rubber bent or folded over the end of the pencil and held there by a metal socket or ferrule.*" 162 163

And he further says (fol. 394,) *It is difficult to tell from the Gray application whether the Gray head was a solid concave piece or not* but I have supposed that it was."

And in fact, his testimony in the interest of defendants is evidently based, and depends upon this *supposition.*

(*c*) The nature and scope of *Blair's* said invention appears in the specifications and drawings annexed to his said Letters Patent, and in his said application of January 6, 1859, as conclusively explained by Complainant's expert, Mr. Treadwell. 164

Moreover, the testimony of *Blair* and the witnesses *Shive* and *Haggenmiller*, clearly indicates what was the *prominent* and *important idea* and *device* by him intended and invented..

165 Testimony of *J. B. Blair.* (Fols. 248–250, 345–347, 352, 354, 360–361.)
Testimony of *David Shive.* (Fols. 230–231.)
Testimony of *Otto Haggenmiller.* (Fol. 240.)
Testimony of *Emory Rider.* (Fols. 270–273.)

And the expressed opinion of Defendant's expert, W. C. Dodge, as referred to, and quoted *supra*, of identity between the alleged invention described in Gray's said application of 1856, and said invention of Blair, is evidently wholly based upon his erroneous *assumption* the
166 *doubt* of which *he himself admits;* and upon the assumption, also, that Gray is entitled to the *broad claim* of a rubber head pencil *without reference* to *device* or the *method* of *attachment* or *application;* and that therefore Blair's invention is *subordinate:* which last assumption is without merit as a reason for invalidating Blair's said patent; for even if such *generic* claim be *patentable* it is evident that, as a matter of *fact*, it cannot be urged against Blair's Patent.

It is evident that these assumptions are resorted to by
167 Mr. Dodge, to sustain, so far as he concientiously could, an opinion required by the defence; but the correctness of which he felt to be open to much doubt.

3. With respect to Blair's Patent, even could there be any conflict between them, *Gray* must be held to have *forfeited* any claim he might have had.

It cannot be said that the grounds upon which *Blair's* alleged abandonment is disproved apply at all to the case
168 of *Gray.* There is a wide difference between *forfeiture* and *abandonment.* The one operates in favor of *another inventor;* the other in favor of the *public.*

Jenkins v. *Barney et al.*, Com. Dec., 1873, 3 Off. Gaz., 119.
Hyatt v. *French*, Com. Dec., 1873, 4 Off. Gaz., 609.

In *Blair's* case the question arises with reference to a 169
patent already granted, as to which *vested rights* have been acquired and existed for years. In *Gray's* case the question was whether he had not *forfeited* his right to a patent, corresponding rights having in the meantime *vested in another original inventor* who has obtained a *patent* and the invention having gone into *extensive use*.

There also appears a wide difference in the *facts* in the two cases.

Gray's application was, also, *withdrawn* and the patent 170
fee *returned*, and his present statement (fol. 297), that he did not *authorize* such withdrawal by his Solicitor, can avail nothing as against a *third person*. Moreover, he does not claim to have at any time *repudiated* such withdrawal, or to have corrected the inferences to be drawn from it. On the contrary, unlike the case of *Blair* his *ability* to have prosecuted his application, had he *desired* to do so, is evident. He *admits* that he *owned at the time* and had owned *for some years* a *farm in Vermont of eighty acres*, which in 1857 or 1858, he *exchanged* for *a house in Medford*, *Mass.*, which house he bought, but had the deed made 171
in the name of his *wife* the farm being *valued at* $800, and he *paying* $800 '*to boot*' in payments of $100 or $150 per year until paid.

(Fols. 300–301, 319, 321.)

It also appears (fols. 303–304) that he *owned various stocks* and was in receipt of *considerable wages* for his skilled services, and (fol. 316), that he has in all obtained and applied for *fifteen or twenty patents in this country and others*, from about 1854 to the present time, and he says that they were "*most all since* 1856, *there might have been* 172
one before."

That he did not choose to proceed further to perfect and give the public the benefit of his invention, in the absence of personal constraining necessity, indicates a *laches* on his part which must prejudice his claim against

173 a *subsequent patent*, and throw grave doubts upon the *fact* of his having proceeded farther than to make certain *incomplete experiments and trials* of which the *public* never had any real benefit nor could well have had, but which were *by himself abandoned, and suffered to remain unknown.*

Household v. *Neilson*, 1 Webs., Pat. cas., 673, 718.
Curtis on Patents, § 91, and cases cited.

That he was willing to renew his abandoned application after *another* had *perfected* a rubber head pencil, and it had *become of great value* provided he could do so *at some*
174 *one's else expense*, does not aid his case.

It does appear that, *in fact, for more than thirteen years after his said application and alleged invention in* 1856, *he took no steps at all to renew it*, for his application of 1861 was for a *simple rubber tube*, and could not be considered a renewal.

In fact, he makes a substantial *disclaimer* in it, stating, "I am aware that rubber heads have been applied to lead pencils, but not in so cheap and convenient a form as I apply them; nor were they so easily applied and removed
175 as by the means which I have invented, nor so firmly held to the pencil."

(Complainant's Exhibit, No.—, fols. 584–585,)

III.—The alleged prior invention, knowledge and use of *Holman J. Hale.*

1. They were not such *perfected invention, public use* or *knowledge* as can defeat the said *Blair Patent;* nor can he
176 be said to have reduced his invention to practice, in patentable sense.

This is one of the matters set up in defence at the last moment, and covered by the amendment consented after the testimony was closed.

Hale simply claims to have attached in 1855, and subsequently *tubes* made of india-rubber, which were *then on*

sale to pencils, by *drawing them over the ends of the pencils;* 177
and to have fro m time to time *given away* several of these pencils so fitted with the tubes.

He made no effort whatever to obtain a patent until *four years after*, when, *after* both said *Blair* and *Shaw* had *applied for patents* and said *Shaw* had *obtained* one, said *Hale filed an application* which was *rejected*.

More than six years after this rejection, he requested of the Patent office that an *interference be declared*, which was *refused* on the ground of *abandonment* and a subse- 178
quent similar application *in* 1869 was also *refused*.

(DEFENDANT'S EXHIBIT, E. E. FOLS. 476–487.)

It is evident that his application of *rubber tubing* to pencils was a matter simply of *experiment* and *curiosity*, and with *no intention* at the time to give the benefit of his suggestions to the *public*, or to *patent it* and that his application for a patent, when, by *independent invention*, the rubber head pencil had become *of value*, or was *likely* to, and after *Blair's* appplication had been filed, was simply an attempt on his part to *wrest* from *another* the mo- 179
nopoly *he* was fairly entitled to, and which *Hale had not himself contemplated*.

This is fairly inferable from *Hale's* own testimony (fols. 368–369); and he himself speaks of his different plans as "*conceptions, thoughts and ideas.*" (Fol. 370.)

Counsel for defendants endeavored to get Hale to include, as *one* of his "*conceptions*," a "*solid rubber head, covered at the end and held to the pencil by the elasticity of the rubber around the socket.*" (Fol. 370); but he declines to give any positive answer, saying, "*I think I did in my* 180
experiments." "I think I *tried* that and a good many *other* plans at different times—*conceptions, thoughts* and *ideas;*" but, although pressed by repeated questions to answer *certainly* he reiterates only that he "*thinks*" he did; and being asked on cross-examination what had become of such pencil, *if* he *had* made one in his *experiments*, says, "*I never gave it away; I have not the remotest*

181 *idea what became of it; I did not propose to use it, or make it, well knowing they could probably be done cheaper than I could purchase them, and leave me any profit.*"

2. Even if, so far as the application of a simple tube is concerned, said Hale could be considered to have sufficiently reduced it to practice, or it could avail against *Blair*, which is emphatically denied it is clear that *identity* between *it* and the *rubber head* described in the *Blair Patent* is *wanting.*

182 Testimony of Complainant's Expert, *Francis C. Treadwell, Jr.* (Fols. 281–290.)

IV. The alleged prior invention of *William W. Shaw*, or, as it now is claimed, the *joint* invention, of *him* and *Philander Perry*, as anticipating the invention of said *Blair* has even *less* to sustain it.

1. It was not *perfected* or *reduced to practice* prior to the
183 application of said *Blair* of January 6, 1859, even if anything amounting to *invention* can be held to have been done before.

All that said *Shaw* claims to have done *prior to February*, 1859, is to have drawn some designs (fol. 406), which have *disappeared*, (fols. 407–408); and to have had some *wooden models* turned the exact shape and size of said drawings (fol. 406), which have, *also*, *disappeared*, and which he states he has not seen *since* February, 1859. (Fol. 410.)
184

It does not appear that he had, or carried out, the idea of *moulding* rubber tips until *February or March*, 1859; and then, *after* his application to his Patent Solicitors, and "*by their instructions*" (fol. 407); and upon cross-examination, his ignorance as to the *method* and *operation of moulding* is so conspicuous as to justify the inference that

he had not *contemplated* any such process until *after* his application (fols. 411–412); in fact, being asked (fol. 414), *who suggested* making the heads by means of a *mould* he answers, "*I don't remember whether it was my own or some one's else suggestion.*" Being asked if it was not Munn & Co.'s, or some one's in their employ, he answers, "*I don't remember; I think* the idea was my own." Being asked *why* he thinks so, he answers, "Because I think it would *naturally* occur to me that *that* would be the *way* to make it;" and being asked if that is *all* his reason, he answers, "Yes, sir." And he states that he did not, that he remembers, *prior* to coming to New York and *making his application, make any model whatever* except those he states he turned out of *wood.* Moreover, (fol. 413), not only this alleged *mould,* but also the "*about a dozen*" *tips,* he *thinks* were made from it, have *all disappeared,* and he don't know what has *become of them,* or when he *last saw them.* 185 186

Philander Perry Shaw's brother-in-law claims that *he* made the invention, and *not Shaw,* and that *he* made drawings of a rubber head for pencils (fol. 417), and that Shaw's *models* were *his,* and paid for by *him.* (Fol. 418, Ans. to Q. 12.) 187

On cross-examination he admits that he did *no more* than make *drawings* until *January,* 1859 (fols. 419–420, Ans. to X Qs. 19, 20, 22, 23), when, he says, he and Shaw went to New York, and had *models* made, and (fols. 420, Ans. to X Q. 24,) he states that *Shaw* in the month of *February* engaged a person to make the *mould,* "and it was *some time after that* he *received the tip.*"

He does not *produce* his said drawings, and as for these *moulded rubber heads* he states (fol. 525) that they were *burned up* at the fire in Troy. 188

He also admits, (fol. 421, Ans. to X Q. 32), that he was one of the *subscribing witnesses to Shaw's application.*

189 *Shaw* (fol. 415, Ans. to X Q. 128), states, being informed of *Perry's* claim of invenfion, that they made it *together*.

2. As a matter of fact, the invention of said *Blair* was prior in point of time.

Shaw states that he made his invention in the City of Troy in *November* or *December* 1858 and the idea was then suggested by tying an ordinary piece of rubber to the end of a pencil (fol. 405, Ans. to Qs. 4, 5.) He states
190 he tied it "along the *side* of the pencil at the end," (fol. 415, Ans. to X Q. 121).

But it is evident from his own testimony that he is able to fix the time of his alleged invention, and of his making the alleged drawings and wooden heads *only* from his being sick at Troy at the time, and from his mother's congratulations on New Years's Day, 1859, and therefore he says, "I *believe* the invention was made by me in November, but certainly prior to January 1, 1859" (fol. 406—Ans. to Qs. 7, 8); and, again, that he has a "*strong*
191 *impression*" that he made the *drawing* and *wooden models prior to January*, 1859, and in *November*, 1868, but "*I can give no special reasons.* (Fols. 408–409.)

Philander Perry testifies to making the alleged drawings "*about October* or *November*, 1858, and *even* prior to that" (fol. 416); and again (fol 418), "I made drawings *about two months previous to October or November*, 1858—*rough drawings, or sketches on paper of different forms.* But, being pressed, says (fol. 419—ans. to 12, 16), "*It*
192 *was along about in September that I commenced making drawings, the precise date I could not tell.*"

It is claimed that there is no testimony which can be held to prove any *invention* whatever, within the requirements of the patent law, on the part of either *Shaw* or *Perry*, or *both*, *until subsequent to January*, 1859.

Blair filed his application *January* 6, 1859. More- 193
over, he testifies that he made his invention and drawings, *including the drawing annexed to, and filed with, his said application*, in the *summer of* 1858. Fols. 248–250.

3. In relation to the *interference* declared between the *application* of *Blair* and the *patent* of *Shaw*, in which *priority* was awarded to *Blair*, *Levi L. Tower* states (fol. 175): "After this interference was declared, I *tried to find Mr. Shaw*, and learned that he was *dead*, and *tried to find out* whether or no he did not invent this moulded 194
head prior to his *application* for his said patent; which fact I did report to my solicitor, that I was *unable* to find anything to establish his invention *save* what the *records* showed," and that (fol.) 176) he *heard* that *Shaw* was *dead* "from some one in Boston, of whom I made inquiry. The person's name I am not able to state, but think it was his brother-in-law."

And *Shaw himself* admits (fol. 415) that there was a period when it was *feared* by his *family* that he was *dead*.

This is sufficient to account for his *testimony* not being 195
taken in the Interference Case; and the testimony in the present case shows that *had* it been, *Blair* has the *superior* right to a patent; and that, in awarding priority to *him*, the Patent Office simply did what *must* have been done in 1859, even considering them both as independent, competing inventors.

And that Shaw obtained a *patent* in 1859 upon an application filed *after Blair's* had been *rejected*, cannot now be invoked to the prejudice of *Blair's patent*, for it was *improperly* granted, without declaring any *interference*, 196
and entirely *ignoring Blair's prior application and rights.*

Appeal of *John W. Cochran*, SUPREME COURT, District of Columbia, decided December 1, 1869, *supra*.

Blair's application was filed January 6, 1859, and refused January 12, 1859. (Fol. 592.)

197 *Shaw's* was filed February 12, 1859 (fol. 435). It was at first refused for want of novelty; but no reference made to *Blair's prior application* (fol. 437); and a patent was granted him April 5, 1859. (Fol. 450.)

V. The novelty of said Blair's said invention is further attacked by the defendants by the allegation that it was described in a *printed publication*, entitled "*Personal Narrative of the Origin and Progress of the Caoutchouc or India-Rubber Manufacture in England, by Thomas Han-*
198 *cock*," *published in London in* 1857, and especially at the *plate* opposite page 116, which is put in evidence; and also by the testimony of *Edward Oelzner* (fol. 396), showing sales of *nipples* made of India-rubber, intended to be and applied to bottles for artificially nursing babes. (Defendant's Exhibits O, E, fol. 397.) In other words, by the defence of "*double use*."

So far as the alleged *printed publication* is concerned, nothing is shown save a *plate*, on which appears a small figure, and under it, the word "*nipple*." There is no
199 *description* whatever.

This is clearly *insufficient*—

Seymour v. *Osborne*, 11 Wall., 516.
Reeves v. *Keystone Bridge Co. et al.*, U. S. CIRCUIT COURT, Eastern District of Pennsylvania, 1872; 1 Off. Gaz., 466, 471.
Judson v. *Cope*, LEAVITT, J., Law's Am. Dig., 609, pl. 9.

Nor can the invention of said *Blair* be considered a
200 *double use* or *new application* of the *nipple* testified to have been before sold, within the principles or authorities upon which that doctrine depends.

Strong et al. v. *Noble et al.*, 3 Fisher, 586.

Moreover, if it *could* be considered in any respect a new use, it would not avail; for it is also well settled that, if in the new use any new function is performed,

or an old function in a better manner, or effects already known are produced, but so as to be more economically or benefically enjoyed by the public, or a new, or better, or cheaper article of manufacture is produced, it is patentable. 201

Ex parte H. L. Smith, App. Cas., 1853.
Ex parte Seeley, App. Cas., 1853.
Ex parte Blandy, App. Cas., 1858.
Ex parte Newman, App. Cas., 1859.

But in fact, it cannot be fairly said that there is *any* real resemblance between the *nipple* and the *Blair rubber head*. That the former may be *irregularly* and *inconveniently used* so as to *erase pencil marks* constitutes none. 202

The testimony of defendant's own expert, *W. C. Dodge*, is conclusive as to this. (Fols. 401–403)

Nor can such use of the said nipple, *in fact as an eraser*, as is testified by the witness *Edward Oelzner*, be of any importance, for he admits it was done, as he expresses it, "*more for play than any thing else* (fol. 397, Ans. to Q. 13) and again he states "*We only used them for private use.*" (Fol. 398, Ans. to X Q. 31). 203

Such a use would not afford ground for a charge of infringement of an unchallenged Patent; *a fortiori*, it will not avail to *defeat* a patent.

In *Poppenhusen* v. *Falke, et al.*, 2 Fish., 11, it was held that "an experiment with a patented article for the sole purpose of gratifying a philosophical taste, or curiosity, or for mere amusement, is not an *infringement* of the right of a patentee."

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In conclusion, it is respectfully urged by Appellants, that the Defendants have, in all respects, failed to sustain the burden of proof resting upon them; and that the decree of the Circuit Court should be reversed, and a decree made granting the prayer of the Bill of Complaint.

JOHN S. WASHBURN,
Counsel for Appellants.

Supreme Court,

OF THE UNITED STATES.

No. 321.

THE RUBBER TIP PENCIL COMPANY.

Appellants.

vs.

SAMUEL E. HOWARD, HENRY SANGER, MICHAEL SNOW and RICHARD BUTLER.

Appeal from the Circuit Court of the United States, for the Southern District of New York.

Brief on behalf of Respondents.

FREDERIC H. BETTS

Counsel for Respondents.

New York:

S. Hamilton & Sons, Printers, 61 Cedar St., N. Y.

1874.

S. Hamilton & Sons, Printers, 61 Cedar St., N. Y.

Supreme Court of the United States

ON APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF NEW YORK.

THE RUBBER TIP PENCIL COMPANY,

vs.

SAMUEL E. HOWARD, HENRY SANGER, MICHAEL SNOW AND RICHARD BUTLER.

Brief on the part of the Repondents.

This suit is founded upon the patent of J. B. Blair, dated July 23d, 1867, No. 66.938, for a Rubber Head for lead pencils.

The Bill also alleges the grant and infringement of the patents of Hymen L. Lipman, dated March 30, 1858, of Vosburg & Ludden, dated May 20, 1862, of Frank E. Oliver, dated June 3, 1862, of Eberhard Faber, dated June 16, 1863, of James B. Hodgskin, dated February 14, 1865, of George M. Merritt, dated March 5, 1867,

re-issued May 7, 1867, of J. B. Blair, dated July 23, 1867, of Samuel D. Hovey, dated July 28, 1868, and of Joseph Reckendorfer, dated January 19, 1869.

None of the Letters Patent mentioned in the bill have been put in evidence by the complainants, except the patent to Blair, nor have any assignments been proved of any other of said patents to the complainants, nor has any testimony been taken by either party upon the issues raised, as to the patents other than Blair's.

The suit is therefore considered as if instituted upon the patent of J. B. Blair solely.

The bill charges infringement, and prays an account. The answer denies the novelty of the invention; alleges that the alleged invention of Blair had been abandoned to the public, and that the alleged invention was neither new, useful, or patentable.

The case was brought to a final hearing before his Honor, Judge Benedict, in the before mentioned court, and his decision was in favor of the defendants, and the bill was dismissed.

The complainant appealed to this court.

The points to be considered are—

1st. The construction of the Blair patent.

2d. The question of infringement by the defendants.

3d. The question of the validity of the Blair patent, in view of the defences interposed.

I. The construction of the Blair Patent. (Ex. 1, p. 295.)

The specification opens with the statement, that the inventor J. B. Blair has invented "a new and useful Cap or Rubber Head, *to be applied* to lead pencils, &c., for the purpose of rubbing out pencil marks."

After referring to the drawings, Mr. Blair states that the nature of his invention "consists in making the head of *any convenient external form*, and forming a socket longitudinally in the same to receive one end of a lead pencil, or a tenon extending from it."

The head " may have a flat top surface *or any other that may be desirable;*" within one end of the said head is formed a cylindrical or *other proper shaped* cavity." This socket is usually made "about two-thirds through the head and axially thereof, but if desirable, the socket or bore *may extend entirely through the said head.*"

The inventor then goes on to say, " that the drawings exhibit the elastic head so made, as to cover the end as well as extend around the cylindric sides of the pencil, *but it is evident that the contour of the said head may be varied to suit the fancy or taste of the artist or other person*, and I DO NOT LIMIT my invention to the precise form shown in the drawings as it may have such *or any other convenient for the purpose, so long as it is made to compass the pencil and present an erasive surface about the sides of the same.*"

The head "may be applied not only to lead pencils, but to ink erasers and other articles of like character."

The claim is to "an elastic erasive pencil head, made substantially in manner as described."

The claim is *not* for the *combination* of the erasive head with a pencil, but for the erasive head *itself, apart* from its connection with the pencil.

It is perfectly apparant from the specification that the invention claimed is a very broad one. It is in substance for a piece of erasive material, of *any* external form suitable for rubbing out pencil marks, having in it a hole or socket, extending *entirely* or *partly* through the same, and of such size that a lead pencil "or *other articles,*" could be inserted in the hole, and in that case the piece of rubber would be held on by the elasticity of the rubber.

Not a word is found limiting the invention to any particular form of head. On the contrary, it is expressly stated that it may have the form shown in the drawings or *any other* convenient for the purpose."

Not a word is found limiting the invention to a head having any particular form of internal cavity or socket. On the contrary, it is expressly stated that the socket is "cylindrical or *other* proper shaped cavity." That is,

the cavity should be of the shape of the article to which the head is to be applied ; if to a round pencil, cylindrical; if to a hexagon pencil, then of that shape; if to an ink eraser, with protuberant or ornamented head, then of the shape of that head.

Not a word is found limiting the invention to a head made or manufactured in any particular way. It might be cut, stamped or molded. Of course the method of manufacture would only concern the facility and cheapness of production, not the essential character of the thing made.

Not a word is said of the size of the article, or the actual depth of the socket, or the thickness of the rubber parts.

The claim is for an erasive head made so as to be capable of encompassing the sides of a pencil or other article, and present an erasive surface about its sides. Under these conditions the head may be of *any* shape, of internal form, manufactured in *any* way.

Any piece of rubber, into a hole in which, a pencil, or other article, could be inserted, and which in that case (if the article was large enough to fill the hole) would tend to hold to the article so inserted, and would present an erasive surface about the sides of the article, would be an infringement of the patent.

Judge Benedict properly decided that such a claim in such broad terms, amounted to a claim to "a piece of rubber with a hole in it," and, so claimed, was not patentable.

The complainants have found it absolutely necessary to *attempt* to limit the scope of the Blair invention in order to render the device patentable, and also to try to prevent the clearest anticipation.

These abortive attempts we consider first.

During all the early part of the case the endeavor was to try to show that Blair's invention was for a *molded* pencil head.

Joshua Gray, who was produced to prove prior invention, was cross-examined as to having made or seen *molded* heads, p. 145, qq. 166, 171.

William W. shaw was vigorously cross-examined to the same effect.

Defendants' Proofs, p. 213, q 63 et seq.

Emory Rider was examined to try to interpolate into the specification his "understanding" of what would be a proper mode of making tips. Record, pp. 121 to 122.

To *settle* this question the defendants went into the enemy's camp and produced Blair himself, in Philadelphia, on the 9th day of February. 1871, and asked him the question—(p. 165.)

Q. 6. "Did you ever *mold* any rubber tip? A. NEVER."

The complainants declined to cross-examine at that time; but on April 27, 1871, two months and a half after, they produce Blair in *New York* for *cross*-examination (?), having brought him on themselves and paid his expenses (Record p. 111, q. 178-80), and endeavor to show that he was the inventor of *molded* rubber-tips. (Questions 47 to 54. Rec. pp. 169-170.) Any apparent ambiguity raised by the leading character and erroneous assumptions of the questions by the complainants, were, however, effectually disposed of by the after-examination by the defendants.

That examination was as follows (Record, p. 174):

"ReDQ. 90. You spoke, in your cross-examination, of "having invented *molded* rubber-heads; did you ever do "anything more than *contemplate* the possibility of molding "rubber-heads? A If the question means—did I ever "mold any rubber-heads, I answer, No.

"ReDQ. 91. What did you do with regard to molding "rubber-heads, beyond thinking that that would be a good "way to make them? A. Having determined by my experi- "ments the practicability and utility of the invention, I im- "mediately took measures to secure a patent right; *beyond* "*that, I do not know that I did anything practically.*

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"ReDQ. 92. Will you, please, to point out in the specification of your application of January 6th, 1859, anything in relation to molding the rubber-heads therein described? A. I think the word *molding* is not used here at all, but I can see in accordance with my usual mode of making out my specifications, I have used the broadest term that I had at command, and, therefore, have used the word "made" instead of molded.

"ReDQ. 93. You did "make" a rubber-tip, and not "mold" one? Is not that so?

"A. *Yes, sir.*

"ReDQ. 94. Now, did you ever do anything about molding except to contemplate its possibility? A. How much the phrase, "ever do anything," may cover, I am not sure in my mind; I shall, therefore, have to say as I said before.

"ReDQ. 95. What did you do in relation to molding rubber-tips, except to think about it? A. The reason I hesitate to give a positive answer is, that it seems to me probable that I conversed with Mr. Shive *about india rubber works*; I know I have done so; and in regard to the facility of getting different things made in that line, further than some movements of this kind, *I feel quite sure I did nothing.*"

It is as clear as noonday that Blair not only does not limit his invention in his patent to molded rubber-tips, but that he *never invented molded* rubber-tips.

It is a noticeable fact that the complainants' expert, Mr. Treadwell, cannot be induced to countenance so absurd a claim, and says nothing about it.

If his invention was really confined to molded rubber-tips, then he did not disclose in his specification the *best* mode of making his invention which was known to him, and his patent would be void.

Page *vs.* Ferry, 1 Fisher, 298; Curtis on Patents, § 237.

The next ingenuity of construction of the Blair patent to which the complainants resort to try to save it was never thought of, or hinted at, until Mr. Treadwell came into the case on the 23d day of October, 1871.

The new departure in construction then taken was, that

the Blair invention was limited to a head which has a *swell* or *projection* on the side, upper or lower end, or middle of the head, so as to give the head greater thickness of rubber at some parts of its length than at others. (Complainants' Proofs, p. 129, XQ. 15).

This construction is attempted principally to try to meet the proof of prior use of rubber-heads for pencils, which were the same size throughout their whole length.

This desperate resort in construction is, however, wholly inadmissible for two sufficient reasons :

1st. The patent itself says that "the invention consists in making the heads of *any* convenient external form ;" and it is further stated that the heads claimed "may have a flat top surface," or it may be of a semicircular or conical shape, or ANY OTHER that may be desirable. "The *socket* may *extend entirely through* the head." Again, "the contour of the head may be *varied* to suit the *fancy* or the *taste* of the artist *or other person*." And the inventor adds, so that there can be no mistake as to the scope of his claim, "I DO NOT LIMIT MY INVENTION *to the precise form shown in the drawings, as it may have such or* ANY OTHER *convenient for the purpose,* SO LONG AS IT IS MADE TO ENCOMPASS THE PENCIL AND PRESENT AN ERASIVE SURFACE ABOUT THE SIDES OF THE SAME."

Not one word about any "swell" or "projections" on any part of the head as constituting an essential part of the invention ; on the contrary, the only qualification made to the broad claim is, that the head must "encompass the pencil and present an erasive surface about the sides of the same."

If there is any form of tips which more than another fulfills this express condition of the patent, *i. e.*, that it shall "present an erasive surface about the sides" of the pencil, it is that in which the head is the same size and form all the way up. Any "swell" or "projection," especially at the top, would *prevent*, not create, "an erasive surface about the sides of the same."

What person examining the Blair patent, to ascertain what was claimed and what was not, could possibly discover that heads having "swells" or "projections" at their tops, bottoms, or middle, *were* the *only* ones claimed, and that heads of the same size throughout were excluded.

Such a conclusion could be reached only by an ingenuity, not prompted by fairness, but by a predetermined intention to sacrifice the language and obvious purport of the description to the necessities of the case.

If Blair's invention really was a head having "swells" or "projections," and only such, then his patent would be void, because it does not adequately point out what his invention is, or distinguish it from what is old.

Wintermute *vs.* Reddington, 1 Fish., 239.
Judson *vs.* Moore, Id., 544.
Curtiss on Patents, § 230.
Dixon *vs.* Moyer, 4 Wash., 68, 73.
Moody *vs.* Fiske, 2 Mas., 112, 118.
Campion *vs.* Benson, 3 Brod. & B., 5.

2d. Blair himself removes every difficulty on that point, he has no such subtle distinction between forms of heads in his mind.

He is asked (Defendants' Proofs, p. 166, q. 12).

"Q. 12. Look at defendants' Exhibit O and P" (P being "a tube rubber-tip with no "swells" or projections) "and "state whether they are not substantially the same as that "for which you made application for a patent? A. THEY "SEEM TO BE SUBSTANTIALLY THE SAME."

The claim for the Blair patent is for a rubber head of any form, and made in any way, the only essential feature of its construction being that it must have the capacity *when applied* to surround the pencil and present an erasive surface about the sides of the same.

Judge Benedict, in the Court below, properly decided to the same effect. He says:

"An effort has been made to show that the erasive "capacity of the Blair head is increased by means of cer- "tain swells or projections on the sides of the head,

" which are portrayed in the drawings, and supposed to " be indicated in the specification as a feature of the in- " vention claimed ; but I find no language which can " fairly be said to convey the idea that such swells or " projections form a part of the invention ; on the con- " trary, the description states that the head may be of " any convenient external form, and expressly declares " that the invention is not limited to the precise forms " shown in the drawings, but may have any convenient " form, 'so long as it is made so as to encompass the pencil " and present an erasive surface about the sides of the " same."

When we come to speak of the history of this patent, in connection with the state of the art, this construction will become still more apparent.

II. INFRINGEMENT.

The second question to be determined is that of the alleged infringement by the defendants.

On the broad construction given to the Blair Patent, the defendants Howard, Sanger & Co. ,have undoubtedly sold goods substantially similar to those described in the Blair Patent, though the form of heads sold by them differs from Blair's.

III. THE THIRD QUESTION TO BE CONSIDERED IS THAT OF THE VALIDITY OR INVALIDITY OF THE BLAIR PATENT.

The defences on the question of validity are two in number.

1st. The want of Patentability of the device *as* claimed by Blair.

2d. Prior inventions by various persons.

3d. Abandonment of the invention by Blair prior to obtaining a patent.

1st. The question of the want of patentability is fully and exhaustively discussed in Judge Benedict's opinion in the court below. It is impossible to add anything to it as there urged. The position is so clear as to render it almost unnecessary to consider any further points; but for the sake of completeness, we advert to the following heads of the defence.

2d. Under the defence of prior invention, the defendants rely to anticipate Blair's Patent, on—

(*a.*) The prior invention of Joshua Gray, and application for a patent therefor, filed September, 1856.

(*b.*) The prior invention and patent of William W. Shaw, dated April 5th, 1859.

(*c.*) The prior invention of Holman J. Hale, and application for a patent therefor, filed July, 1859.

(*d.*) The prior knowledge, use and sale, and printed description of articles of rubber, within the description of the Blair patent, which could have been, and in fact were, used for rubber-tips for pencils, though intended for another purpose.

Before considering in detail the separate defences on the question of original inventorship, it will be useful, in order to understand the relation of the claimants to each other and to the parties in this suit, to attend to the history of applications for patents for rubber-tips for pencils, and rubber-tipped pencils, as shown by the official records of the patents.

The applicants for patents on this subject prior to the time of the grant of Blair's Patents have been the following, in the order named :

1. 1856, Sept. 18. Joshua Gray. Deft.'s Ex. A., p. 222.
2. 1857, January 7. H. L. Lipman. Deft.'s Ex. S.
3. 1859, January 7. J. B. Blair (the patentee in the present case). Deft.'s Ex. B , p. 225.
4. 1859, February 12. W. W. Shaw. Deft.'s Ex. C,, p. 227.
6. 1859, July 25. H. J. Hale. Deft.'s Ex. EE., p. 252.
7. 1859, Nov. 2. George Wood. Deft.'s Ex. V.
8. 1861, August 20. Arthur Neil. Deft.'s Ex. FF.
9. 1861, Sept. Joshua Gray. Compt.'s Ex. p .
10. 1862, April. F. E. Oliver. Deft.'s Ex. U.
11. 1862, April. Vosburg & Ludden. Deft.'s Ex. T.
12. 1862, May 14. L. L. Tower Re-issue of Shaw's patent. Deft.'s Ex. X., p. 250.
13. 1862, June. Joseph Reckendorfer. Deft.'s Ex. R.
14. 1863, February. Eberhardt Faber. Eeft 's Ex. Q.
15. 1864, James B. Hodgskin. Deft.'s Ex. H.
16. 1867, January. J. B. Blair (the patentee in the present case). Deft.'s Ex. E., p. 233.

The nature of these several applications, the action of the office upon them and their result, are clearly and briefly stated in the opinion of the Hon. R. L. B. Clarke, one of the Examiners-in-chief of the United States Patent Office, in the interference case between the application of Joshua Gray, the first applicant, and the other applicants. (Deft.'s Exhibit DD.) Mr. Examiner Clarke then said :

" The following facts appear :

" 1, Gray applied September, 1856, claimed broadly com-
" bination of rubber eraser with pencil, by means substan-
" tially, as shown. He showed a common pencil, with rub-
" ber attached to the upper end, and held in a metal socket
" or cap, from which it projected. But he suggested that
" the rubber might be otherwise fixed; the gist of his in-
" vention being the combination claimed.

"Rejected as not patentable, and on reference to Pond, "who showed a crayon rubber, but not a crayon *and* rubber.

"2. Lipman applied January, 1857; claimed broadly the "combination. Rejected on reference to Gray. Amended "and limited to drawing pencils, with rubber inserted in "similar manner to the lead, &c. *Patented*, March 1858.

"3. Blair applied January, 1859; claimed the appendage to "lead pencils, constructed substantially as shown. He "showed substantially the same device as Gray, and was "rejected on reference to Gray, and withdrew his applica-"tion.

"4. Shaw applied February, 1859; claimed a head for "pencils made of rubber, and attached by means of a socket, "and suggested that it might be molded,

"Rejected on reference to Pond and Gray.

"5. Shaw renewed his application, April, 1859, and "amended by limiting his claim to *the head shown*, that being "conical, and having a recess to fit over the head of the pen, "cil. (Not differing materially from Gray.) Patent issued "April 25, 1859.

"6. Hale applied July, 1859: claimed combination of "rubber-eraser and pencil. Showed several ways of attach-"ing, substantially like Gray, Blair and Shaw, and was re-"jected on reference to them.

"7; Woods applied November, 1859; disclaims broad "combination, but limited to springing rubber over conical "or tapering knob on the end of pencil. Rejected on refer-"ence to Shaw and Hale.

"8. Neil applied August, 1861; claimed pencil and eraser "combined, and was rejected on reference to Hale.

"9. Gray—2d application September, 1861; claim limited "to a peculiar mode of construction of rubber tips, viz.: 'a "piece or section of elastic India rubber tubing, &c.'

"This would have been subordinate to his first invention, "if not fully answered by it, but was rejected on reference "to Hale and Neil.

"10. Oliver applied in April, 1862, and was rejected on "reference to Hale, and in a second letter, on reference to "Gray.

"He disclaimed a rubber-tipped pencil, but claimed a com-"bined sliding sleeve and eraser, to be used on a pencil.

"On appeal to the Examiners-in-chief, he was allowed for "his peculiar device, as not being fully answered by the ref-"erences, and patent issued June 3, 1862.

"11. Vosburgh & Ludden applied in April, 1862, and "claimed for a special device for holding rubber on pencils, "consisting of rings and clamps, &c. Patented, May 20, "1862.

"12. L. L. Tower applied for a re-issue of Shaw's patent "May 14, 1862, puting in a disclaimer to the use of *metallic*

" *ferrules* or *sockets* to hold the rubber, and claimed for the " combination of pencil and rubber head or ferrule to encom- " pass the pencil or a tenon thereon, and also claimed the " pencil head, as shown. This was allowed without any " question or declaration of interference, though it was an- " ticipated by Gray.

" 13. Reckendorfer applied June, 1862, and was rejected " on reference to Lipman.

" On appeal, the Board of Examiners-in-chief allowed the " application.

" He disclaimed the broad combination of rubber and " lead in the same case, but claimed a tapering case, larger " at the rubber end, to give space for the rubber, which was " inserted like Lipman's, in combination with the lead of " smaller dimensions. It was at most, but an improvement " on Lipman's.

" Patented November 4, 1862.

" 14. Faber applied February, 1863; disclaimed combina- " tion of rubber head and pencil, but claims a pencil with an " angulated rubber seal head, &c.

" Patented June, 1863.

" 15. Hodskin applied August, 1864; claimed a pencil " point protector, and a sleeve holding rubber, to slip over " the point of the pencil, when not in use, and on the other " end to be used as an eraser. This was rejected on refer- " ence to Vosburgh & Ludden, and B. L. Cohen, who is not " in interference, and whose files are not before the Board, " but who simply showed a protector without rubber. Al- " lowed by Examiners-in-chief, and *patented* February 14, " 1865.

" (It was but the uniting of two devices).

" 16. J. B. Blair re-applied January, 1866, and was put " in interference with Shaw only, although we see he had " been rejected on reference to Gray.

" This renewed application was for the sole benefit of " Cutter, Tower & Co., and Tower files his affidavit, that " being engaged largely in manufacturing, under Shaw's " patent, he discovered that Blair was the prior inventor, " and asked for an interference with Shaw, and ' in order " ' to prevent the invention from becoming public property, " ' on account of long use,' *he asks that a patent may issue to* " *Blair*, if it prove true that he was originally entitled to " it. Notice was served on Tower for taking Blair's testi- " mony. None was taken for Shaw, and priority was award- " ed to Blair, as ' no opposition was shown by the parties " ' interested in Shaw's patent '

* * * * * * *

" It thus appears that though several since Gray have " applied for the broad combination of rubber and pencil, " yet they have all been rejected on reference to Gray. All

" of them seemed satisfied with the reference, and in some " instances amended and limited their claims to the peculiar " construction of the eraser or the mode of attaching it.

" Of the ten or a dozen patents granted not one of them " covers the broad ground of Gray's invention, although it " it is evident that many of the specifications and claims " were drawn with a view of flanking and avoiding Gray, or " the objections urged against his application, and yet gain " the same object arrived at by him.

" They are, however, clearly subordinate, if not fully met " by Gray's invention.

" As far as the Blair and Shaw patents and re-issues are " concerned, they seem to have been clearly and fully anti- " cipated by Gray, and to have been issued with a full op- " portunity for knowledge, on the part of the applicants, of " the infringement upon Gray's invention.

" The application of Gray was improperly rejected. This " seems to be admitted on all hands."

It may further be stated as part of the history of their case that the invention of Gray has been finally *patented*.

The Supreme Court of the District of Columbia having reversed the decision of the Patent Office, which rejected it on the ground of *laches*.

This, however, is since the hearing of this cause in the Court below.

This being the history of rubber-head patents *inside* the Patent Office according to the statement of one of its principal officers, we next look at the history of the efforts of the claimants to the invention in question *outside* the records of the Patent Office as developed by the proofs in this case.

This branch of the history of the art is as follows :

Joshua Gray made his application in September, 1856. He exhibited his invention at the Mechanics' Fair, in Boston, in the Fall of 1856, when it was open to the inspection of 30,000 or 40,000 persons. (Gray's Ev. Record, p. 135, qq. 22, 23. Ray's Ev., p. 155, qq. 14, 15. Exhibit Gray, Sept. 29, 1871, p. 150, qq. 245, 246). He

has ever since that time been perseveringly endeavoring to obtain his patent. (Gray's Ev., p. 139, qq. 10 to 20. Ray's Ev., p. 154, q. 13. Steven's Ev., p. 156, qq. 5, 6, 7, 8. 9. Sargent's Ev., p. 158, qq. 4, 5, 6, 7, 8. Roger's Ev., p. 160, q. 3. Ball's Ev., p. 162, qq. 3, 4. Brown's Ev., p. 163, qq. 3, 10, 11 ; also Exhibits AA, BB, CC, DD, p. 244).

J. B. Blair, the present patentee, never made but one rubber-tipped pencil (Record, p. 173, q. 83), and *that was different from the kind claimed in his present patent* (p. 173, q. 85). He made a *suggestion* of the tip now patented, in his application of January, 1859 (Ex. B, p., 226 foot), but *never actually made a single specimen* (p. 173, q. 86); his application was rejected on Gray's case (Ex. B, p. 223); he promptly *acquiesced* in the rejection, and withdrew his application (Ex. B, p. 227); and with the exception of an occasional conversation on the subject with an intimate friend or two, slept on the matter for nearly eight years, when he sold out to Levi L. Tower, the assignor of, and a member of the complainants, for a mere bagatelle, and never has done anything else.

William W. Shaw made an application within a month of Blair: he had a number of rubber-heads molded and specimens filed in the Patent Office (Record, p. 210, qq. 14, 15, 16, 17; and he showed it extensively in New York, and advertised it (p. 217, q 129). He sold it to Hale in August, 1860. (Ex. W., p. 243). From Hale it passed into the hands of Cutter, Tower & Co. and Levi L. Tower, and the trade was fully supplied with the article from 1861 onwards. (Tower's deposition, p. 64, qq. 195 to 198).

Holman J. Hale made his invention four years before Blair (Record, pp. 183-4), and applied for a patent about six months afterwards. From time to time he has sought an interference with other applicants; his application, unlike Blair's, has never been withdrawn. (Ex. EE, p. 252).

Wood and Neil do not appear to have done anything beyond filing their applications.

F. E. Oliver, Vosburg & Ludden, Eberhardt Faber and James B. Hodgskin, put their inventions into public use in large quantities from 1862 downwards. (Hovey's deposition, Record, p. 263, qq. 3, 4).

Levi L. Tower, as assignee of William W. Shaw, re-issued the Shaw Patent of April 5, 1859, on May 14, 1862. This re-issue is almost identical in phraseology with the Blair Patent. (Ex. X, Record, p. 311). This patent was acknowledged by the trade, and Tower and his firm enjoyed its fruits until 1867. (Tower's deposition, Record, p. 64-5).

In the latter part of 1865 Tower accidently learned of the existence of the Blair application of 1859. (Tower's deposition, p. 65, q. 206-19). He went to see Blair, found him ready to sell for any sum, and bought the Blair application for a trifle (Tower's deposition, p. 67, qq. 231 to 274; Blair's deposition, p. 177, q. 121).

By a *collusive interference* between *himself*, as the representative of Blair and *himself*, as the representative of Shaw, Tower managed in some unaccountable way to obtain a new patent for himself, in Blair's name for seventeen years, without any interference with any other of the prior applicants. (Deft's Proofs, p. 232 to 237; Ex. D, E, F).

In this way, having had a monopoly of the invention for six years under the Shaw Patent, he seeks to obtain an additional monopoly of seventeen years under the Blair Patent. None of the other applicants appear to have done anything with their inventions. The defendants, however, claim to have right to manufacture and sell under the assignees of Gray, the first applicant.

The history of rubber-heads for pencils being now understood, we proceed to consider the special defences raised in this case.

The defendants allege that the invention of Blair, who procured the patent, dated July 23, 1867, upon which this suit is founded is anticipated.

1st. By Joshua Gray, who applied for a patent nearly *three years* before Blair first applied, and more than *ten years* before he made the application on which the patent was granted.

2d. By William W. Shaw, who applied for a patent within a month after Blair's rejected and withdrawn application, and obtained a patent *eight years* before Blair's successful application.

3d. By Holman J. Hale, who applied for a patent within six months *after* Blair's rejected and withdrawn application, and who made the invention several years before.

The first question to be determined is, when did Blair make his alleged invention? His patent is dated in 1867; that patent is for the erasive-tip, capable of surrounding a pencil, and of being held to it by the erasive material about the sides of the same.

He attempts to carry the date of this invention more than *eight* years back of the date of his patent.

In order to do this he introduces a *rejected* and *withdrawn application* of his, dated January 6, 1859.

In this rejected and withdrawn application, Blair describes chiefly a cylinder of rubber held to the pencil, not by having the pencil stock inserted into it, but by being encased in a metallic cylinder, which holds the rubber and fits securely to the pencil.

In answer to questions 4 and 5 [Record, p. 165), he testified as follows:

"4. Q. Describe the attachment to lead pencils for which "you made application for a patent on the 6th of January, "1859? A. The model which I made and deposited in the "Patent Office consisted of a common wood pencil, with a "corrugated ferrule on the top end, half on the pencil and "half of it projecting above; within the projecting part of "the ferrule, a plug of india rubber was inserted, partly "projecting; the object of the ferrule was to secure the rub-

"ber upon the pencil head; the ferrule was made of silver "tubing or German silver, and the rubber was a solid piece "of ordinary india rubber.

"5. Q. State how you formed the rubber-tips deposited "as models in the Patent Office, and all on which you "claimed an invention? A. I don't remember making any "other than this completed model, but I have forgotten "all of the phraseology of my former application; what I "remember in regard to making the rubber-tips is, that I "punched the plugs out of a solid piece of india rubber; I "don't remember making them in any other way.

"6. Q. Did you ever mold any rubber-tip? A. Never.

And in answer to questions 82, 83, 84 and 85, p. 173, he says:

"ReDQ. 83 How many rubber-tip pencils or rubber-"tips for pencils did you ever make? A. I made one for "the Patent Office, and then, probably, several in the way "of experiment.

"ReDQ. 83. How many do you distinctly remember, "which you can positively state, were completed? A. There "is but *one that I ever considered completed.*

"ReDQ. 84. Is that the one you sent to the Patent Office "for a model? A. *Yes, sir: that is the one.*

"ReDQ. 85. That one was a solid piece of rubber held to "the end of a pencil by a metallic ferrule, solely, was it not, as "delineated in figures 1 and 2 in the drawing attached to "your application? A. *Yes, sir.*

After clearly describing in his specification this sole form of rubber-head of a pencil which Blair ever made, (a form, no suggestion of which is found in the patent on which this suit was brought,) Blair goes on at the end of the rejected specification to *suggest* that, "instead of the ferrule and cylinder" of rubber, "the cap *may* be made entirely of rubber or other suitable material;" and he gives a sectional drawing (Fig 3) of such a *projected* cap, (but one clearly in an unpracticable form.)

It is upon this *suggestion* of Blair's as to what "*may*" be made, but which HE NEVER DID MAKE, that the complainants, his assignees, are trying to sustain a patent, and by it enjoin and make tributary the defendants, who claim under inventors who did a thousand times more than Blair did to give the benefit of this invention to the public.

Blair was expressly asked whether he *ever made a*

single rubber tips such as described in his present patent, and his answer was. (Deft.'s Proofs, p. 173, qq. 86 and 87.)

Never a complete one; but I approximated to that form as nearly as practicable, by punching a hole through a solid piece of rubber." It was a piece of rubber about a quarter of an inch thick, originally made for the purpose of rubbing out pencil marks; the pencil head was cut out of this piece of India rubber, and as nearly as I can remember, was shaped barely enough to answer my purposes of experiment."

Here are the complainants attempting to obtain a monopoly of valuable rights, not upon the strength of the disclosure and gift to the public of a useful invention, but upon a written *suggestion* of something the alleged inventor *never did*, but only *suggested* in a paper filed among the secret archives of the Patent Office, and lying hid until more than eight years after the public have been in full possession of the invention.

When the complainants called Blair to New York, two months after his direct examination, for what they call his cross-examination (?) they try to make out that the rubber cap, shown in Fig. 3 of his rejected application, was the principal invention of Blair, and the thing he made was only a subordinate form made for convenience.

This statement was however one evidently drilled into him in the interval between his Philadelphia examination in February, and New York examination in April; for on his Philadelphia examination when asked how he formed the rubber tips which he claimed as his invention, after describing the only pencil he made—the Patent Office model with the metallic ferrule, he says;

"I don't remember making *any* other than this completed "model, *but I have forgotten all the phraseology of my former* "*application*; what I remember in regard to making rubber "tips is, that I punched the plugs out of a solid piece of In- "dia rubber, I don't remember making them in any other "way."

It can hardly be that this alleged inventor's *principal* idea was the one he had forgotten, though he had looked

at the specification and drawings before him, while he could accurately describe the *subordinate* invention.

At a late stage in the case, *six months after his former examination*, Blair is again recalled by the complainants to try to carry his invention still further back than he did before, so as to try to anticipate Shaw. (Record, p. 112, q. 184.)

When *then* asked when he made the invention of a rubber-tip pencil, he says, (p. 110, q. 163), "*probably* in the summer of 1858." He is next asked, (q. 164,).

"What did you do? A. I conceived the notion of attaching India rubber to a pencil, and *immediately* attached a piece of rubber to a pencil to determine its utility. Having satisfied myself of its utility, I proceeded to perfect the invention by making a drawing of the forms I deemed best."

He is then asked when he made the different drawings in his application of January, 1859, and he says (q. 165),

"*I must have* made them all at about the same time."

(Evidently a mere supposition.) He fixes the time when he conceived of this rubber head and made the drawings, by connecting it with the making of drawings for an electro-magnetic ruling machine (qq. 170, 171, p. 110.) He is then asked whether he made the drawings for the socketed rubber head, like Fig. 3 in his application, before or after he made the other forms. His answer is still a mere supposition.

A. "*I have hardly a doubt* that my ideal of a rubber-headed pencil at that time is represented by Fig. 3, and *therefore* I must have put that in the form of a drawing first, the other drawings 1 and 2 were made with reference to making a model."

On cross-examination (Record, p. 112, q. 185, 186,) he testifies, in answer to questions, as follows:

"185 Q. Did you make any of your drawings for a rubber-tip pencil before you determined the utility of the thing, by making a pencil of that kind in some shape? A. *I am satisfied I did not.*

"186 Q. Your *first* action in the matter then, was *to make a rubber-tip pencil*, and *then* to put your ideas in the shape of drawings, was it? A. *Yes, sir.*

On further cross-examination he admits that he made

his application for a patent for his electro-magnetic ruling machine *after* he made that for his rubber-tip pencil, and it was patented March 19, 1859, (qq. 187, 188, p. 112.)

Here then is the sum of the endeavor of the complainants to prove the time of Blair's *conception* of the invention back into the summer of 1858.

The conception was "probably in the summer of 1858," *because* he was engaged on an electro-magnetic ruling machine at that time. This is the only circumstance he has to fix his memory as to its being in the summer of 1858; but the application for a patent for this ruling machine was not made until *after* the application for a patent for the rubber tip, hence the time he was making his drawing for his subsequent application can hardly, without anything else, fix the time when he conceived his prior invention.

But we have a better test of the accuracy of Blair's memory on this point. As already seen, *immediately* upon his conception of the idea, he made a rubber-tipped pencil to illustrate it (q. 164).

His *first* action in the matter was to make a rubber-tip pencil, and *then* to put his ideas in the shape of drawings (q. 186).

Now, unfortunately for the accuracy of his recollection, hazy though it is, concerning the making of his drawings in the summer of 1858, he had on one of his previous examinations *fixed the time*, as nearly as he could, *when he made his first rubber-tipped pencil.*

On April 27, six months before, he had been asked (Record, p. 193, q. 80),

"How long before your application of January 6th, 1859, "had you ever made a rubber-tip pencil? A. *I don't think* "*it was longer than a few weeks, but I don't remember precisely.*

In April, 1871, he did not think it was longer than a few weeks before his application of January 6th, that he made his first rubber-tip pencil. In October, 1871, he says he "probably" made his drawings (which he admits were made *after* his first rubber tip) in the summer of 1858.

The contradiction is instructive, as to the anxiety of the witness to sustain the complainants' case, and the infirmity of his recollection, both as to the date of his "conception" of the invention, *and also as to his own testimony relating to it.*

The truth is, that the form of pencil head principally described by Blair in his specification of January, 1859, was the only one he ever invented; *when he came to draw his specification*, the alternate form shown in fig 3 suggested itself to him as *possible*, and he inserted it *as a suggestion.*

He never carried that suggestion out. After circumstances, *i. e.* the seeing heads manufactured under the Shaw Patent in the market, reminded him more forcibly of that cap form than his principal one, and thus gave it for a time greater interest in his mind, and this temporary prominence he now recalls, yet even that was forgotten by him after he sold his rights to Tower. And when examined first in the case, as already seen, *he had no recollection of anything except the pencil with metallic sleeve*, which he had actually *made*, and chiefly described.

It can not be possible that a mere suggestion of the possibility of making a thing in a certain form, unaccompanied by any actual formation of the article can support a patent, (Whitely *vs* Swaye, 7 Wall, 685,) certainly it cannot when there are in the field other *bona fide* inventors, who *actually made* the thing in question, and who promptly made applications for patents. Especially when, as in this case, the claimant, who only *suggested* the invention, made no effort to publish the same, but allowed it to sleep for years in the Patent Office, while the substantial benefit to the community, *which is the consideration of the grant*, was conferred by the others who actually created the article, and who prosecuted their discoveries with diligence.

These prior inventors to Blair are Joshua Gray, William W. Shaw, Holman J. Hale.

(*a.*) Gray made his invention in the summer of 1856, two years and a half before Blair.

He made the invention in three forms.

1st. A rubber cap fitting over the end of the pencil, Exhibit N, and partly surrounded by a metallic cap.

2d. A large hexagon-shaped cap, in every respect similar to Blair's. Exhibit O.

3d. A tube of rubber fitting over the pencil precisely similar to that form of the Blair head in which the socket went entirely through the head. Exhibit P.

There is no dispute but that Gray anticipated Blair in his invention. Nor is there any dispute but that Exhibit O is substantially similar in all respects to the Blair head. (Record, p. 190, q. 10.) This head, Exhibit O, is undisputedly proved by Gray himself (p. 134, q. 6 and 24,) and by E. M. Stevens. (P. 156, q. 4.)

It can make no differecne that this head is roughly made. It is *equally efficient and useful*, as the best heads made under the Shaw and Blair patents by their assignees. Roughness of a rubber head does not affect its utility.

The objection of roughness in construction comes in bad grace from *Blair's* assignees, Blair himself never having *completed a head at all;* the only thing he did do was to make a still *rougher* head with a hole *entirely through it.* (Blair dep. Record, p. 173, qq. 86 to 88.)

This form of head by Gray is not an *unperfected experiment*, but a *complete* and *practical* thing.

It was evidently one of the forms invented by Gray for which he made application for a patent, which he exhibited to others, and which he has perseveringly striven to patent through all the years since.

A single specimen of the invention, if complete and capable of use, is sufficient to defeat a patent of a subsequent inventor.

Coffin *vs.* Ogden, 3 Fisher, 640.

Since affirmed by this Court.

The Gray rubber head, Exhibit O, was, in the words

of that decision, "a complete, working" rubber head, "requiring no alteration, adaptation, addition or improvement to fit it for use." "It was put in a practical form," in proper material, "and was ready for practical use in itself, and as a pattern or model from which any number like it could have been made;" "and the persons who saw it understood its construction." "It was therefore a completed and perfected invention, and the imparting of a knowledge of its construction, by its exhibition to the persons who saw it and understood its arrangement, was the giving to the public such a knowledge of it, as a completed invention, before 'Blair' made his invention of the same thing as to deprive 'Blair' of the right to be considered in law as the first inventor of such invention."

Reed *vs.* Cutter, 1 Story, 590.
Bedford *vs.* Hunt, 1 Mason, 302.
Curtiss on Patents, sec. 87.

The only contest as to the Gray rubber heads is with' reference to Exhibits N. and P. The complainants allege that neither of these Exhibits are substantially similar to the Blair rubber head.

Exhibit P. they claim, being merely a tubular head, is not substantially like Blair's; Blair's invention being limited to a rubber head, having "swellings" or "projections" on the sides.

We have already considered this point in determining the construction of the Blair Patent, and shown that the patent includes rubber heads of *any* external form, and those in which the socket extends entirely through the head.

It is perfectly evident from the history of the art that the Blair Patent must have been drawn to include the Oliver heads made by J. J. Merritt, which, as Mr. Hovey states (Record p. 263, q. 3), were in the tubular form, and were used from 1862 onwards.

Blair himself, as we have seen, admits that the tubular rubber heads are within his Patent. (Record p. 166 q. 12.) Nor did the complainants ever think of denying

it until after Mr. Hale had proved the use of such heads, long prior to Blair's alleged invention.

The mere difference in form, if it amounts to anything, accomplishes no new result; it, at most, merely increases slightly the capacity for somewhat *longer* use, but *involves* no *invention*, and is not in any way pointed out as essential, or distinguished from what is old in the patent.

There must be a difference in principle to constitute a patentable difference. "A change in form from the constitution of an existing article, or in its proportions, is not a substantial change in the eye of the patent law. Such changes require no great ingenuity, and do not call for the exercise of the *inventive* faculty; they are simply the work of a mechanic."

Tatham *vs.* Le Roy, 2 Blatchf., 485, 486.

"Merely to change the form of a machine is the work of a constructor, not an inventor. Such a change cannot be deemed invention."

Winans *vs.* Denmead, 15 How., 341.

"A change of form merely, or of mechanical structure, the *practical effect of which is small*, and for which no *new* or *materially* improved result is obtained, is not the subject of a patent."

Sargeant *vs.* Larned, 2 Curt., 349.

See also to the same effect—Cahoon *vs.* Ring, 2 Cliff, 592; Chatfield & Dutcher, Laws. Dig., p. 337, 46; and numerous other cases cited in Laws. Dig. title Form. Many of these cases relate to changes of form as affecting the question of infringement, but the same principles apply in considering the question of patentable novelty.

The force of the attack of the complainants has been directed, however, against the rubber-tipped pencils made by Joshua Gray, like Exhibit N.

This form is specially described in his application of 1856.

It consisted of a rubber cap slipped over the end of

the pencil, and in turn partly enclosed in a metallic head.

This rubber cap. described in the Gray application, is in itself a complete anticipation of Blair's alleged invention.

Its *practical construction* preceded Blair's conception of the invention by two years.

It consisted of a solid piece of rubber, cut into the form of a cap, and a hole of suitable size drilled into it. It is directly within the wording and claim of Blair's patent.

It has a rounded external form and top; it has a socket formed longitudinally in it, to receive one end of a lead pencil or a tenon extending from it; from the inherent nature of the rubber, it will be held to the pencil by the elasticity of the rubber, if the pencil or tenon on the same is of suitable size; its form is such that it will encompass the pencil, and present an erasive surface about the sides of the same.

It is entirely immaterial that this form of head made by Gray was, in practice, partly encased and supported by an outer metallic head on the pencil. Blair's patent is for *the head itself*, not for any particular method of its combination with a pencil or other article.

The complainants apparently concede the fact that if Gray's rubber head was made in the way described, and would hold to a pencil by the elasticity of the rubber, it would anticipate Blair's patent. But they contend that Gray's rubber head, as described in the drawings of his application of 1856, was nothing but a little disc of sheet rubber bent over the end of the pencil, and held on by being clasped by the metallic head. If this was the case, of course it would not anticipate Blair's patent.

But what are the proofs on this point.

Gray himself swears it was a solid head, made like Exhibit N. At page 134 he testifies:

"4. Q. Please describe particularly how you constructed "the rubber-tipped pencil shown in the drawings of said "application. A. I took a piece of hard rubber and made

"a hole in it about a quarter of an inch, perhaps three-
"eighths, then whittled down to fit the metallic head, then
"cut the pencil down so as to slip into the rubber about three
"eighths of an inch.

"5. Q. Of what was the metallic head made? (Objected
"to as before.) A. It was, I think, of German silver; it was
"cut off—the first—from a pencil case, and cut out to make
"it fit well.

And at page 136 he says:

"24. Q. In answer to Question 8, you stated that you
"would have made and produced specimens showing the
"several forms of rubber tips made by you. Have you had
"any specimens made? and if so please produce them. A.
"I have made the specimens and produce them."

Specimen with metallic head is put in evidence, and marked Exhibit N.

"25. Q. Will you please describe in what manner the ex-
"hibits you have now produced were made, and whether or
"or not those in answer to Questions 4 and 6 you stated you
"made in 1856, were constructed substantially similar or
"different? A. The rubber head was made from solid
"rubber, the hole bored in, and whittled down, small at the
"bottom end, the corners taken off, leaving the head to cor-
"respond with the Exhibit, as near as could be made. The
"second was a simple piece of tube cut off and slipped on
"to the pencil. The rubber made for the metallic head was
"made from a solid piece, drilled out to fit the end of the
"pencil, the tip polished down to fit the metallic head and
"rounded off on the top; it is as near like the model made
"in 1856 as two could be made."

This description is nowhere shaken by a cross-examination extending over more than two hundred questions, and is fully sustained by Gray's specification, filed in September, 1856. (Ex. A., p. 222.)

He there describes the rubber eraser as a "convex piece of rubber"—a designation utterly inconsistent with the idea that it was a flat disc of sheet rubber bent around the pencil.

Gray's testimony is fully confirmed by John Ray. who assisted him in making his application for a patent in 1856, and saw his original model.

At page 153 Mr. Ray testifies as follows:

"In. 3. Do you know anything, and if so what, of any
"invention of said Gray relating to rubber-tipped pencils?
"Please state, if you know, when, if ever, said Gray made

the pencil, and in turn partly enclosed in a metallic head.

This rubber cap. described in the Gray application, is in itself a complete anticipation of Blair's alleged invention.

Its *practical construction* preceded Blair's conception of the invention by two years.

It consisted of a solid piece of rubber, cut into the form of a cap, and a hole of suitable size drilled into it. It is directly within the wording and claim of Blair's patent.

It has a rounded external form and top; it has a socket formed longitudinally in it, to receive one end of a lead pencil or a tenon extending from it; from the inherent nature of the rubber, it will be held to the pencil by the elasticity of the rubber, if the pencil or tenon on the same is of suitable size; its form is such that it will encompass the pencil, and present an erasive surface about the sides of the same.

It is entirely immaterial that this form of head made by Gray was, in practice, partly encased and supported by an outer metallic head on the pencil. Blair's patent is for *the head itself*, not for any particular method of its combination with a pencil or other article.

The complainants apparently concede the fact that if Gray's rubber head was made in the way described, and would hold to a pencil by the elasticity of the rubber, it would anticipate Blair's patent. But they contend that Gray's rubber head, as described in the drawings of his application of 1856, was nothing but a little disc of sheet rubber bent over the end of the pencil, and held on by being clasped by the metallic head. If this was the case, of course it would not anticipate Blair's patent.

But what are the proofs on this point.

Gray himself swears it was a solid head, made like Exhibit N. At page 134 he testifies:

"4. Q. Please describe particularly how you constructed "the rubber-tipped pencil shown in the drawings of said "application. A. I took a piece of hard rubber and made

"a hole in it about a quarter of an inch, perhaps three-
"eighths, then whittled down to fit the metallic head, then
"cut the pencil down so as to slip into the rubber about three
"eighths of an inch.

"5. Q. Of what was the metallic head made? (Objected
"to as before.) A. It was, I think, of German silver; it was
"cut off—the first—from a pencil case, and cut out to make
"it fit well.

And at page 136 he says:

"24. Q. In answer to Question 8, you stated that you
"would have made and produced specimens showing the
"several forms of rubber tips made by you. Have you had
"any specimens made? and if so please produce them. A.
"I have made the specimens and produce them."

Specimen with metallic head is put in evidence, and marked Exhibit N.

"25. Q. Will you please describe in what manner the ex-
"hibits you have now produced were made, and whether or
"or not those in answer to Questions 4 and 6 you stated you
"made in 1856, were constructed substantially similar or
"different? A. The rubber head was made from solid
"rubber, the hole bored in, and whittled down, small at the
"bottom end, the corners taken off, leaving the head to cor-
"respond with the Exhibit, as near as could be made. The
"second was a simple piece of tube cut off and slipped on
"to the pencil. The rubber made for the metallic head was
"made from a solid piece, drilled out to fit the end of the
"pencil, the tip polished down to fit the metallic head and
"rounded off on the top; it is as near like the model made
"in 1856 as two could be made."

This description is nowhere shaken by a cross-examination extending over more than two hundred questions, and is fully sustained by Gray's specification, filed in September, 1856. (Ex. A., p. 222.)

He there describes the rubber eraser as a "convex piece of rubber"—a designation utterly inconsistent with the idea that it was a flat disc of sheet rubber bent around the pencil.

Gray's testimony is fully confirmed by John Ray. who assisted him in making his application for a patent in 1856, and saw his original model.

At page 153 Mr. Ray testifies as follows:

"In. 3. Do you know anything, and if so what, of any
"invention of said Gray relating to rubber-tipped pencils?
"Please state, if you know, when, if ever, said Gray made

"any such invention, and describe the same? (Objected to "on the ground that Gray himself is the proper party to "answer that question) A. I know that he invented a "rubber-tip pencil in 1856; *it was a piece of rubber cut out—or a "hole cut in it*—so as to fit on the end of a pencil, and into a "metallic cap, or cup; I saw him at the same time, or about "that time, have a piece of rubber with a hole cut entirely "through it; and also a piece of rubber tubing on a pencil.

"In. 4. Please look at the rubber-tipped pencil marked "'Defendant's Exhibit N. J. G., Jr.,' and state how the "same resembles or differs from the rubber-tip pencil of said "Gray, which you first described in your last answer. A. "*That is a most perfect representation of it.*

And at page 35:

"In. 16. Did you ever see the model which Mr. Gray "sent with his application to the Patent Office? If so, "please describe the same. (Same objection.) A. *I couldn't "describe it better than by referring to that, Exhibit N.*

And at page 36, on cross-examination:

"Re X 1. In the model sent to Washington, was the "head of the pencil cut down, and the point inserted in the "rubber with the cup between, as in Exhibit N? A. Yes, "sir; it was.

"Re X 2d. How do you know the metallic cup was put "on only for ornament? A. I did not say, sir, it was put "on only for ornament.

Re X 3d. State all the purposes for which it was put "on? A. It was put on for style and finish, and also to "support the rubber.

"Re X 4th. What was its main purpose? A. Style and "finish.

"Re X. 5th. How do you know that? A. I know a "piece of rubber was cut out with a knife, and it was rather "rough looking; Mr. Gray suggested that he'd get a metal-"lic head or cap and put on, and press that on to the pencil, "and into the cap or cup.

"Re X. 6th. How was the hole made in the rubber-"head? A. It was drilled with a drill.

The evidence as to Exhibit N having been a solid tip is also confirmed by the fact of Gray's having made two other forms without the metallic head, which were slipped on to pencil and held on by the elasticity of the rubber. (Ex. O and P, and Ed. M. Stevens, p. 156, q. 4. Ray, p. 154, qq. 5 and 6).

It is inconceivable that Gray, knowing as he is shown to have done, the simple and obvious way of slipping a

solid piece of rubber over a pencil, should have resorted to such a difficult, inconvenient and impracticable method of illustrating his invention as the supposed one of binding a little disc of rubber over the pencil and trying to secure it by the metallic head.

Now, as opposed to this overwhelming proof by the inventor himself, and by the man who helped him to apply for a patent for the invention, by the expression of the specification itself, and by the extreme *naturalness* of placing a solid rubber cap on the pencil, the complainants have nothing except their imagined construction of the drawing of Gray's application, which their own expert, Mr. Treadwell, admits does not determine the matter, and the testimony of Mr. George B. Sargeant a workman of Cutter, Tower & Co., and under great obligations to them, who, on his examination in this case, admits that he never saw Gray's pencil until 1859, three years after his application, but is quite sure it was only sheet rubber.

He admits, however, on cross-examination, that he had previously sworn in the Gray interference case that his notion was only an "impression," and that he "never examined it closely." (Record, p. 120, q. 83).

His cross-examination shows also the impracticability of fastening a piece of rubber of the sheet kind to a gold or silver pencil case, and he finally confesses he does not know how it was done (p. 120, q. 89-93).

As between the men who saw the original invention, and closely examined it at the time it was made, and the one man who saw something years afterwards, which he "never examined closely," and has only an "impression" about, the Court cannot doubt as to the real construction of this invention of Joshua Gray.

The complainants also contend that the rubber-head of Gray, which he sought to patent, would not have held on to the tenon of the pencil on which it was placed by the elasticity of the rubber with sufficient force to withstand all the hard usage to which it might be subjected if the metallic head was removed.

They have brought no evidence to prove this, except an expression of opinion by Mr. Treadwell.

On the other hand, Mr. Gray says positively, from actual tests, that the rubber-head can be practically used without the metallic head (p. 156, qq. 253, 254, 255), and Blair himself reluctantly concurs in that opinion. At cross-question 145, he says (p. 189):

"ReXQ. 145. In your invention described in your application of 1859, and delineated in figure No. 3, you have "stated that the head was made entirely of India rubber "held upon the pencil stock by the force of the rubber itself. Please look at Exhibit N. and state, if the metallic "cap be removed, the piece of rubber put upon the end of "the pencil without the fastening of the clasp would be so "held upon the pencil stock as to enable it to be practically "used as a rubber-headed pencil? A. *I have no doubt it "could be used successfully in rubbing out pencil marks.*

At re-direct question 154, p. 182-3:

"ReDQ. 154. Have you not, during this examination, "used Exhibit N without the metal cap, practically and successfully, and seen it used by others? A. *I think the proper "answer would be, Yes.*

At re-direct questions 126, 127 and 128, p. 178, and 179:

"ReDQ. 126. Now, removing the metal cap of Exhibit "N, and placing upon the end of the pencil the rubber-"head or cap, is not the rubber-tipped pencil in that form "substantially similar to the rubber-tipped pencil delineated "in figure 3 of your said application? A. I don't see any "substantial difference, with possibly the exception of a "groove that I perceive that I made in the top of the pencil in order to make a more secure hold of the rubber.

"ReDQ. 127. Is the rubber-tipped pencil Exhibit N, "with the metal cap removed, as stated in the last question, "substantially similiar to the rubber-tip pencil described "and delineated in the patent issued to you July 23d, 1867, "Exhibit No. 1? A. It seems to me substantially the same; "at all events, the difference that I perceive in the form "would hardly be considered substantial.

"ReDQ. 128. Is the elastic erasive rubber-head on Exhibit N substantially similar to the elastic erasive rubber-"head described and delineated in your Patent Exhibit No. 1? A. I think my other answers are an answer to this "question; it seems to me substantially the same."

This, be it remembered, is from Blair himself. under whom the cmplaina nts claim.

But, aside from all this, the question whether Gray's rubber-head, shown on Exhibit N, would or would not hold to the particular tenon to which it was applied, without the assistance of the metallic clasp, is entirely immaterial, for it is perfectly evident from an inspection and trial of the article, that if the pencil stock is of sufficient size, the rubber-head will be held on with great force

It hardly lies in the mouth of Blair's assignees to assert that a quarter of an inch depth of socket in the rubber-head is insufficient under any circumstances, when the *only* socketed rubber-head Blair ever *attempted* to make was one only *a quarter of an inch* in depth. (Blair's dep., Record, p. 171, q. 87).

It results from the foregoing considerations that Blair's alleged invention was fully anticipated by the Gray invention as shown in Exhibit N, O and P.

(*b*). The next prior inventor to Blair is William W. Shaw.

Shaw and his brother-in-law, the Rev. Philander Perry jointly conceived the invention between September and November, 1858. (Shaw's dep, p. 209, q. 4. Perry's dep., p. 217, q. 3. Helen Perry's dep., Deft's Proofs, p. 231, q. 2).

The invention was *immediately* put into the shape of drawings and wooden models made (Shaw's dep., p. 210, qq. 9 and 10). In January or February, 1859, Shaw and Mr. Perry came to New York to have rubber-tips made (p. 213, q. 61, &c., and p. 231, q. 41); a mold was ordered (p. 213, q. 63, &c., and p. 215, q. 96), a number of tips made precisely like the drawings in the patent afterwards obtained.

An application for a patent filed February 12, 1859, (Ex. W. W. S., No 1 (p. 228); some of the tips so molded filed as models (p. 215), q. 111, and Exhibit W. W. S.. No. 1 p. 231). A patent was obtained April 5, 1859, which covers precisely the invention described in

Blair's patent, on which this suit is brought (Exhibit W. W. S., No. 2 (p. 237). (Dodge Ev., p. 205, q. 5).

Shaw endeavored to put the invention into public use p. 217, q. 129); finally sold it to Hale (p. 243, Ex. W.), from whom it passed to Levi L. Tower (Ex. W., p. 243 to 244), by whom the whole country was supplied with the article (Tower's dep., p. 64, qq. 195, 202. Hovey's evidence, p. 263, qq. 3 and 4).

Here, then, we have the striking contrast between Mr. Shaw and Blair in the matter of this invention. Shaw conceived the invention in the fall of 1858, promptly carried out the conception, *perfected the invention* and *patented* it. Blair probably did not conceive of the invention until the time he made his application in January, 1859, then only *suggested* it as a *possible thing*, and made a *drawing, never perfected the invention, never made or sold a single rubber-tip*, but allowed his incomplete invention *sleep until eight years after the date of Shaw's patent* then sold it for a trifle, and his assignee, Tower, obtained a patent only by a *collusive proceeding*.

As between Blair and Shaw, Shaw is conclusively shown to have been the prior inventor.

The rule is well settled that when a question of priority of invention arises *between independent original inventors*, he is to be considered the prior inventor who first *perfects* the invention and gives the same to the public, and this, no matter which one has had the prior idea. So that it is immaterial whether Blair conceived the invention first, as he tries to show, or not.

Ellithorpe *vs.* Robertson, 2 Fisher, 83.
Agawam Co. *vs.* Jordan, 7 Wallace, 583.
Whitley *vs.* Swayne, 7 Wallace, 685.
Reed *vs.* Cutter, 1 Story, 599.
Washburn *vs.* Gould, 3 Story, 133.
Ball *vs.* Murray, 10 Penn., 112.
Foote *vs.* Silsbey, 1 Blatchf., 464.
Mayhew *vs.* Wardwell, Com. Dec., 1869, p. 5.
Lyon *vs.* Altmair, " " " p. 15.

Hamilton *vs.* Foster,	"	"	"	p. 30.
Boon *vs.* Hinman,	"	"	1870	p. 7.
Dimond *vs.* Hayden,	"	"	"	p. 34.
McClure *vs.* Miller,	"	"	"	p. 122.
Disston *vs.* Emerson,	"	"	"	p. 76.

In Ellithorpe *vv.* Robertson (*supra*), this Court held that "in a race of dilig nce between two independent inventors, *he who first reduces his invention to a fixed, positive and practical form as a priority of right to a patent.*" "To defeat a patent which has been issued," say the Court, "is it not enough that some one, before the patentee, conceived the idea of effecting what the patentee accomplished: to constitute such a prior invention as will void a patent that has been granted, it must be made to appear that some one before the patentee not only conceived the idea of doing what the patentee has done, but also that he reduced his idea to practice, and embodied in some practical and useful form; the idea must have been carried into practical operation; the *making of drawings of conceived ideas is not such an embodiment of such conceived ideas into practical and useful form* as will defeat a patent that has been granted."

The only exception to the rule that he who first *perfects* an invention is the original inventor, is in the case provided for in section 61 of the Consolidated Patent Act, second subdivision, *i. e.* when one person *surreptitiously* and *unjustly* obtains a patent for that which was *in fact* invented (*i. e.* conceived) by another *who is using reasonable diligence in adapting and perfecting the same.*

There is no pretence that either of the applicants in this case "surreptitiously" or unjustly obtained his ideas from the other. Both Shaw and Blair in their relations *to each other* appear to be *bona fide* inventors.

There are also some cases which countenance the doctrine, that he who first conceives the invention, *if* he uses *reasonable diligence in perfecting* the same and *adapting it to use*, is to be considered the prior inven-

tor, though anothor subsequently conceives it, and in fact first reduces it to practical form.

Reed *vs.* Cutter, 1 Story, 599.
Hildreth *vs.* Heath, Laws Dig., p. 424.
Bartholemew *vs.* Sayer, Laws Dig., p. 427.
Eames *vs.* Richards, " " p. 427, and other cases cited in Laws Dig., title "Prior Invention."

This doctrine, however, has no application to the present case; for even if Blair first conceived the invention, he not only did not use *due diligence* in perfecting it, but he *never did perfect it*, or do *more than suggest* it; and to this day has never made a single specimen of that invention to which claim is made in his patent.

Indeed, in view of the decisions of the Courts, it is perfectly plain that Blair's invention was never so perfected as to be patentable.

In Reed *vs.* Cutter, (1 Story., 599,) it was held that until an invention is perfected and adapted to use, it is not patentable. In Cahoon *vs.* Ring, 2 Cliff., 592, it was held that "though drawings of a machine or invention are made from which machines could be constructed, or even if models are made such as may be capable of operation, for the purpose of experiment, yet unless a machine, which is capable of being used and operated as an *actual working machine*, is constructed, then as a matter of law such invention is not complete."

In Seymour *vs.* Osborne, 11 Wallace, p. 552, this Court held that, "he is the first inventor, in the sense of the Patent Law, and entitled to a patent for his invention, who first *perfected* and *adapted the same to use; and it is well settled that until the invention is so perfected and adapted to use, it is not patentable under the Patent Laws.*"

Nor does the *grant of a patent* raise experimental mechanism to the dignity of a completed invention. *Unperfected* machinery has been patented, and in such case the patent declared invalid on that account

The Union Manufacturing Co. *vs.* Lounsbury, 2 Fish., 389.

In Whitley *vs.* Swayne, 7 Wall, 685, this Court declared the patent for the Steadman Harvester void, on the ground that Steadman's invention was *not perfect when patented.*

The force of the defendant's position in regarding Blair as anticipated by Shaw, even conceding, for the purpose of argument, that Blair conceived the invention first, is shown by supposing the case of the defendant being sued for infringing the Shaw Patent. In such case, if they should prove conclusively that Blair *conceived* the invention *first* and made a drawing of it, but *never perfected* a single specimen of the invention, but withdrew his application and allowed it to lie dormant for more than eight years, there can be no doubt but that the Court would sustain the Shaw Patent on the question of novelty, and adjudge the alleged Blair invention to be an unperfected and abandoned experiment.

The complainants however contend that in a suit brought against an infringer, that he is bound to prove, in order to defeat the complainants' patent, that some person other than the complainants' patentee *perfected* the invention, before the patentee *conceived* it.

If such were the rule of law, then the defendants in this case could be held accountable for *all* their profits to *two different patentees:* to Blair's assignees, because Shaw did not *perfect* the invention until after Blair *conceived* it; and to *Shaw's* assignees, because Blair did not *perfect* the invention (he *never* perfected it) until after Shaw *conceived* it.

Such a rule of law would be preposterous.

It fully appears, therefore, from the foregoing considerations, that Shaw was a prior inventor to Blair, and that Blair's Patent of 1867 is anticipated by Shaw's Patent of 1859.

(c.) In addition to the anticipation by Gray and Shaw, is Blair also anticipated by Holman J. Hale.

Holman J. Hale invented rubber tips for pencils in 1854 or 1855; they consisted of a head of uniform size throughout, with a socket running entirely through them (Hale's dep., Record, p. 183 qq. 2 to 13. Grotjan's dep., Record, p. 186, qq. 2–23, and Ennis' dept., Record, p. 188, qq. 3–9.)

Hale applied for a patent about six months after Blair. Blair's invention is fully described in Hale's specification (Exhibit EE. p. 252.)

We have already so fully considered the questions whether the tubular rubber tips are substantially the same as Blair's, whether they are expressly included in his patent, and whether Blair's slight change of form, even if his patent had been limited to it, involving any invention, that it is unnecessary to discuss it again here.

The complainants cannot dispute the fact that Hale anticipated Blair; they rely upon the allegation of substantial difference in the two inventions; in this the facts and the law are against them.

Some stress may perhaps be laid upon the fact that in the decision of the Commissioner of Patents in the Gray interference case, the Commissioner's opinion was, that neither the Gray nor the Hale rubber heads were *perfected* inventions, *because* neither of them showed any *way of producing* them cheaply and speedily.

The Commissioner thinks that the Shaw patent for a "molded" rubber tip and the patent of Arthur Neil for "a mode of making a molded tip," are the ones in which the invention of rubber-tipped pencils was *first reduced to practice*.

If this were so, the same rule would inevitably reduce Blair to the same or a worse condition than Gray and Hale, for Blair not only never "*molded*" a tip, but he never *made* a tip at all.

But the position taken by the Commissioner in that respect was not sound.

We have already remarked that it has, since the decision below, been reversed by the Supreme Court of the District, on Appeal.

Gray's invention and Hale's invention were not "modes of making rubber tips for pencils," but *the articles themselves when made.*

The method of making tips is solely one of convenience, cheapness and facility, not one affecting in any way the substance or characteristics of the article made.

A rubber tip carved out with tools is as useful as a rubber tip, and as perfect in itself, as one that is *molded*, though it takes more time to make rubber tips in quantities by cutting or carving than by molding.

Even doubts as to the *feasibility* of an invention in point of *expense* are no ground for refusing a patent.

Ex parte Cheesbrough. Com. Dec., 1869, p. 18.

Neither Gray nor Hale say anything in their specifications about the methods they contemplate for making their tips, or whether they contemplate *any* method; *neither does Blair.* It was not necessary, as proved by the complainants' own witness Rider (p. 222, qq. 9–10); the state of the art has been such ever since 1846, that rubber tips could have been readily molded as soon as their form was suggested.

Both Gray and Hale *contemplated* molding their tips long before Blair's invention. (Steven's dep., p. 156, q. 5 Hale's dep., p. 183, q. 6.

There was nothing, therefore, which Blair did, *or contemplated*, in the matter of this invention, which was not previously done and contemplated by Gray, Shaw and Hale, and by each much more fully and perfectly than by Blair, and each has shown far greater diligence in preserving their rights than Blair has done.

Blair is therefore fully anticipated by each,

(*d.*) The next defence on the question of novelty is the existence and use of articles of rubber, which, though not designed for tips for pencils, were yet substantially similar to Blair's tip, and could have been, and were in fact occasionally used for the same purpose.

These articles are rubber nipples. They are shown in Exhibits O, E, and in the Hancock Book (published in 1857). The witness Oelzner, without attempt at contradiction, testifies to the public use and sale of these articles, at least from 1855 downwards (Deft.'s Proofs, p. 203, qq. 3–19), and that they were used by him and others for the erasing of pencil marks (p. 203–4, qq. 13, 24–33.)

As we have already seen, the Blair heads do not vary substantially because of thickness, size or shape, nor is the patent limited to any thickness, size or shape.

These nipples were therefore directly within it, and anticipatory of it.

It makes no difference whether the nipples were, in fact, used as erasers before Blair's application of 1859 or not; they were *capable* of such use, and the Blair patent cannot be sustained as a new use of an old article.

The defendants' expert, Mr. Dodge, fully demonstrates the anticipation of the Blair patent by these articles, and no witness for the complainant says anything to the contrary. (Dodge dep., p. 205, qq. 1–4.)

2d. ABANDONMENT.

Having now disposed of the Blair Patent on the question of want of novelty, there is still another defence, that of abandonment.

Blair made his application in 1859. He was properly rejected on the Gray application. He *withdrew* his application, and slept on any rights he might have had for eight years.

In the meantime the invention went extensively into use (Tower's dep., p. 64, qq. 195–200. Hovey's dep., p. 263, qq. 3–4.) Blair knew of this public use from 1861 onwards (Haggenmiller's dep., p. 106, qq. 4, 8, 14); but made no protest of any kind against it, or assertion of his rights. (Blair's deposition, p. 165, q. 9, and p. 176–7, qq. 107, 114.) The only thing Blair ever did was to occasionally speak of the matter to some of his inti-

mate friends; but he is shown not to have made the slightest effort either to press his application or to notify any one of his claims.

The rule that in such a case the application will be considered abandoned, and any right the applicant may have had forfeited, is one which the complainants themselves insisted upon, and for a time succeeded in enforcing against Mr. Gray, in the interference case, in the Patent Office.

Gray's case was one where remarkable diligence had been shown in attempting to get his invention patented, under the circumstances; Blair's case is one where no diligence whatever is shown. Gray's case was one where he did not authorize or know of the withdrawal of his application. Blair's case is one where he voluntarily withdrew his application himself. Both men appear to have had little money, but Gray made attempts to get money from others for the purpose. Blair scarcely lifted a finger in the matter, and he is shown, within a month after his rejection, to have patented, at his own expense, another invention.

Under such circumstances, Blair's application having been *voluntarily withdrawn*, he having known for more than two years of the public use of his invention, without protest, and having made no effort to secure a patent until the invention passed out of his hands, and he was used as the tool of others, under such circumstances, we say, it matters not whether Blair *now* says he "did not intend to abandon." His action in the premises is *conclusive* of such intent.

Nor does the fact that he has obtained a patent better his status, for the obtaining of the patent was a fraud on the public by Tower, and obtained only by *consent* of the opponent, who was the same Tower.

The authorities on the question of abandonment are fully collected and cited in Gray's case. (Compt.'s Exhibit R, pages 15 to 24.)

Pennock *vs.* Dialogue, 4 Wash., 538.
Shaw *vs.* Cooper, 7 Peters, 292.

Kendall *vs.* Windsor, 21 How, 322.
Ransom *vs.* Mayor of New York, 1 Fisher, 252.
Johnson *vs.* Root, 2 Fisher, 291.
Ex parte Cochrane, Com'r Dec., 1869, p. 30.
See especially Bevin *vs.* East Hampton Bell Co., 9 Blatch., 50.

To sum up the case, then—

The Blair Patent must be construed to claim any piece of rubber provided with a hole in it. So claimed, it is unpatentable.

The defendants Howard, Sanger & Co. have sold rubber heads embraced within this claim.

The Blair Patent is also invalid, because of want of novelty.

Joshua Gray, Holman J. Hale and William W. Shaw having been prior inventors of the same article, and substantially the same thing having been made and sold for other purposes, as shown by the witness Oelzner.

The Blair Patent is also invalid, because the alleged inventor voluntarily withdrew his application, and acquiesced for more than four years in the public use and sale of the invention.

The decree below should therefore be affirmed with costs.

FREDERIC H. BETTS,
Counsel for Defendants.

IN EQUITY.

United States Supreme Court.

THE RUBBER TIP PENCIL COMPANY,

Appellants,

vs.

SAMUEL E. HOWARD, HENRY SANGER, MICHAEL SNOW and RICHARD BUTLER,

Respondents.

Appellants' Brief in reply to Brief of Respondents.

JOHN S. WASHBURN,
Counsel.

NEW YORK:
THE FRANK McELROY STEAM PRINTING HOUSE,
99 AND 101 WILLIAM STREET.
1874.

United States Supreme Court,

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Appellants' Brief in Reply to Brief of Respondents.

I.—It is stated in Respondents' brief (p. 2.) to be one of the defences set up in their answer, that Blair's alleged invention "was neither new, useful or patentable."

This is not the fact, so far as relates to subject matter of the invention.

In an amendment consented to be made, after the proofs were closed, alleging prior invention, knowledge and use by certain additional specified persons, it is averred that "in view of the matters and things *above set forth* the said J. B. Blair did not invent anything new, useful or patentable, and that said letters patent granted to him are void."

As already stated, the question of patentability of the *subject matter* of the invention was raised by Mr. Justice BENEDICT himself, and is now for the first time discussed by counsel.

II. It is charged (pp. 5-9) that during all the early part of the case complainants endeavored to show that Blair's invention was for a *moulded* pencil head, and that subsequently, they shifted their ground.

The counsel of respondents has failed to comprehend the object and relevancy of the proofs in relation to moulding.

Moulding was at the time a well-known process, which could be employed in making the article invented, but it was not, and was not claimed to be, any part of the invention itself.

It was well adapted to the manufacture most rapidly and economically of the Blair rubber head, with the peculiar and essential features portrayed in the drawings, and it is claimed, sufficiently shown and described in the specification. That Blair contemplated moulding his rubber heads is confirmatory proof of the nature and features of his invention, and is inconsistent with the broad and loose construction that his invention was merely "a piece of rubber with a hole in it."

That Gray did *not* contemplate moulding at all, strongly indicates that *his* alleged invention was *not* like Blair's, and did *not* have its features; and in connection with his rejected application which shows and describes only a device which was *not* adapted to moulding, and in no respect like Blair's, is almost conclusive proof that his invention was *only* what he there shows and describes.

III. The extract from Examiner Clarke's opinion in the Gray interference, incorporated at length in respondents' brief (pp. 11—14) should, in all fairness, have been accompanied by the statement that it was a *dissenting* opinion. The majority of the board, and, on appeal, the Commissioner of Patents held that Gray never perfected

nor reduced to practice the invention claimed by him; that he was not the first inventor; that aside from the questions of priority and completed invention he forfeited any rights he might have had; and that between his original application of 1856 and the renewed application in his name of 1869, in which it was attempted to cover all the intermediate patents, including Blair's, there was a want of identity.

(Complainant's Exhibits X. Y. Z.)

In like fairness, in stating (pp. 14, 36) what is not contained in the record, ostensibly "as part of the history of their case," that the invention of Gray has since been finally *patented*, and the decision of the Patent office reversed by the Supreme Court of the District of Columbia, it should have been also stated, that the reversal was, by its express terms, *limited* to the one question of *abandonment*, and in express terms "without prejudice to any other question or questions within the jurisdiction of the Commissioner of Patents;" and that by force thereof, the Patent Office, in issuing a patent to Gray, did so, for *only* the specific device shown and claimed in his application of 1856, and in no way covering or affecting Blair's.

From the statements made in respondents' brief it would naturally be understood and it must evidently have been intended that this COURT should understand, that the Patent Office had been compelled by a superior tribunal to issue a patent to Gray for the *same* invention which it is now claimed, in the interests of this defence, that he made like and in anticipation of the invention of Blair. How wide of the truth this is, is evident.

IV.—Recognizing the difficulty of establishing any sufficient anticipation of Blair's invention, provided the continuity of his second with first application be sustained, it is charged in respondents' brief, (p. 16) that Blair's patent was obtained by a *collusive interference*.

This charge must be held to apply to the Patent Office, as well as to Blair and his assignee, for the declaration of the interference and the proceedings which resulted in a final award of priority in favor of Blair, were within the province and control of and the legitimate subject of determination by the Patent Office.

It is to be observed that this charge is not set up in the *answer*, nor is it supported by any testimony, other than the records of the Patent Office.

It is founded simply upon the facts: 1. That Tower was the owner of *both* the Shaw patent and the rights of Blair. 2. That no *other* than the patent of Shaw, was put in interference with Blair; and 3. That, by the issue of the patent to Blair, the term of enjoyment was somewhat enlarged.

No such inference is in any respect justified by these facts.

Only Blair and Shaw ever made, or at that time, had claimed to have made said invention. It was neither claimed nor shown in Gray's early application. His later application, in which it was attempted to cover all the intermediate patents, including Blair's, was not filed until more than two years after Blair's patent was granted. *Only* Blair and Shaw were, or could be, proper parties to such interference.

The determination of the question of priority between Blair and Shaw, was absolutely necessary to secure the exclusive benefit of the invention. Tower had been and was engaged in protecting the invention from unauthorized use; he could have had no other object than to ascertain which, in very truth, was the *first* inventor; in this way only, could he obtain a patent against which the other might not be set up; as in fact, the patent of Shaw *is*, in this case, set up against Blair. It is evident that he could not be benefited by an erroneous award of priority, by the Patent Office.

His petition, already referred to, shows this to be his position, and what he was necessarily seeking to obtain.

That the term of enjoyment of the invention was somewhat enlarged, is entirely immaterial.

Blair's rights were in no way connected with, nor to be prejudiced by the patent wrongfully granted to *Shaw*, or the use of the invention under it.

Pending Blair's wrongful rejection, and the granting of his patent upon renewing his application, the law was changed, and the term of a patent increased, from fourteen to seventeen years.

He was entitled to the benefit of this: he was, also, subject to the provision of the same law, which deprived him of an extension of the patent by the Patent Office, for a period of seven years beyond the original term, which *would* have been open to *Shaw*.

Finally it is submitted that there is nothing shown which should prevent the decision of the Patent Office upon the interference and award of priority, and granting this patent to Blair, from being treated as *conclusive* in this case.

In *Clum* v. *Brewer et al.*, 2 Curtis C C. R. 506, in which a charge of fraud in obtaining the *extension* of a patent was made, the COURT, CURTIS J., said (p. 518.) "I cannot presume that any fraud existed. Of all matters necessary to a valid extension, there is not only a strong presumption arising from the act of extension, but, in respect to the entire merits of the patentee, and the existence of the legal grounds for an extension, the law makes the Commissioner a judge, and in the absence of fraud, his adjudication is conclusive."

And in the recent cases before this COURT of *Guild Ex'r. &c.*, and *Brown* v. *Selby et al.*, 6 Off. Gaz. 392, in which it was set up in the answer, that the reissued patents of complainant were fraudulently obtained, this COURT, BRADLEY, J., held (p. 398,) that: "The question of fraud in obtaining these re-issues, must be regarded as settled by the decision of the Commissioner of Patents."

And in *Gear et al.*, v. *Grosvenor et al.*, 1873, 3 Off. Gaz., 380, in which it was alleged in the answers that the ex-

tension of the patent was procured by fraud, misrepresentation and in violation of law, it was held, SHEPLEY, J., that it is well settled, that a patent cannot, in a collateral proceeding, such as a suit on it, be impeached for fraud in procuring its issue, but only in a direct proceeding to set it aside.

Citing, *Eureka Co.* v. *Bradley*, 11 Wall., 489;
Rubber Co. v. *Goodyear*, 9 Wall., 796.

It is urged, that these cases apply equally to the charge of collusion made in respondents' brief in this case, and *a fortiori*, for in the cases cited the charge of fraud was set up in the *answer*; in the present case it is not.

It is evident that this is an attempt to prejudice the Blair patent in the mind of the COURT, and without merit.

V.—It is argued on the part of respondents, (p. 25,) that the rubber head invented by Blair, with its peculiar features, as compared with the simple rubber tubing, alleged to have been applied to pencils by Holman J. Hale, differs merely in respect to *form*, and does not involve invention.

While a *mere* change of form does not, *per se*, constitute invention, as shown by the authorities cited by counsel, it is equally well settled, that, if, by changing the form and proportion, a new effect is produced, there is not simply a change of form and proportion, but a change of principle also.

Davis v. *Palmer*. MARSHALL, CH. J. 2 Brock., 310.

So where form is a part of the thing invented and essential to its value, it constitutes invention.

Many v. *Jagger*, NELSON, J. 1 Blatch., 386.

So where form and structure enable the operator to do the work in a better manner, or with more ease, or less expense, they constitute a patentable improvement.

Bain v. *Morse*, CRANCH, CH. J. Laws' Dig. 335 pl. 21.

It is submitted that, even if Holman J. Hale *could* be held to have made any invention at all in the sense of the Patent Law, and even if Blair's invention, as compared with what Hale did, *could* be considered to involve a change of form,—both which propositions are controverted,—it was *such* a change of form as is, within the authorities cited, clearly more than a *mere* change of form, and constituted invention.

There can be no better proof of the superior advantages and utility of the Blair rubber head, as compared with a tubing of rubber, or, indeed, with any other device of the kind, than its appreciation by the public and immense sales throughout the country; while the rubber tubing has never gone into use at all, and other devices to a comparatively but slight extent.

VI. It is farther argued on the part of respondents, that Blair and Shaw were both independent, original, competing inventors, and that, although Blair was the first to *conceive* the invention, Shaw was entitled to priority because, it is alleged, he first perfected and gave it to the public, while, it is alleged, Blair did not use due diligence.

It is not denied that Blair followed up his conception with due diligence, by applying for a patent more than a month before Shaw applied, and that, in his application he fully described and claimed the invention.

If then there was any want of diligence on his part, by which his superior rights, as the first to conceive, and the first to apply for a patent and offer to the public the knowledge of it required by the patent law, were forfeited, it was *after* his application was wrongfully rejected; which raises the question of the continuity of his second with his first application, and abandonment, which has been already discussed.

But it is submitted, the point is not well taken by counsel.

It was early settled, that he is presumed to be the first inventor who is the first to apply for a patent, until the contrary is shown in evidence,—which, in the present case, has not been—and that the very filing of the application containing a full description of the invention is *conclusive proof* that the invention has been perfected, and is an effectual means to communicate it to the world.

"Priority of Invention," 11 American Law Register, 608, and cases cited.

In the interference between Blair and Shaw, moreover, the precise question was presented; for Blair's rights rested upon his earlier application, while the invention had, in fact, been put upon the market under the patent of Shaw. But the Patent Office awarded priority to Blair, and it is claimed, properly, and that, in accordance with the decisions already referred to, it ought to be considered conclusive.

It now appears, also, that Shaw's patent was, in fact, *void;* for it is in evidence, that although the invention was alleged to have been made and it was patented to Shaw *alone*, it was really made by Shaw and *Perry;* and a joint patent taken out on the sole invention of one or a sole patent on the invention of more than one, is void.

Slemmer's Appeal. 58 Penn. R.

VII. It is not considered necessary to add anything to what has already been presented in appellants' general brief upon the question of alleged abandonment by Blair, except to refer to one matter, from which respondents' counsel draws an inference of want of diligence.

It was alleged (p. 39) that Blair "is shown within a month after his rejection, to have patented, at his own expense, another invention."

This is hardly candid, for it is, also, shown that Blair did no more to obtain a patent for that other invention

than he did for this. In both cases he prepared and filed the application: one was granted; the other was wrongfully rejected, and he was left a litigation with the Patent Office which he had not the means to undertake or prosecute.

In conclusion, it is respectfully submitted that the respondents have failed to establish any sufficient anticipation of Blair's invention prior to his application of January 6, 1859, and that, upon the proofs and under the decisions, he is entitled to all the rights, to which, at that time, he was entitled, and which were then wrongfully denied him.

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